

***United States Court of Appeals
for the
District of Columbia Circuit***



**TRANSCRIPT OF
RECORD**

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Court of Appeals, District of Columbia

OCTOBER TERM, 1902.

No. 1257.

187

No. 21, SPECIAL CALENDAR.

THE UNITED STATES OF AMERICA ON THE RELATION
OF NATIONAL PHONOGRAPH COMPANY, APPELLANT,

v. s.

FREDERICK T. ALLEN, COMMISSIONER OF PATENTS.

APPEAL FROM THE SUPREME COURT OF THE DISTRICT OF COLUMBIA

FILED NOVEMBER 13, 1902.

COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

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In the Court of Appeals of the District of Columbia.

THE UNITED STATES OF AMERICA on the Relation
of National Phonograph Company, Appellant,
vs.
FREDERICK I. ALLEN, Commissioner of Patents. } No. 1257.

a Supreme Court of the District of Columbia.

THE UNITED STATES OF AMERICA on the
Relation of National Phonograph Com-
pany, Relator,
vs.
FREDERICK I. ALLEN, Commissioner of Pat-
ents, Respondent. } No. 45225. At Law.

UNITED STATES OF AMERICA, { *ss:*
District of Columbia,

Be it remembered, that in the supreme court of the District of Columbia, at the city of Washington, in said District, at the times hereinafter mentioned, the following papers were filed and proceedings had, in the above-entitled cause, to wit:

1 . *Petition for Mandamus.*

Filed February 7, 1902.

In the Supreme Court of the District of Columbia.

THE UNITED STATES OF AMERICA on the
Relation of National Phonograph Com-
pany, Relator,
vs.
FREDERICK I. ALLEN, Commissioner of Pat-
ents, Respondent. } At Law. No. 45225.

The above-named relator, National Phonograph Company, respectfully represents:—

1. Your relator is a corporation duly organized and existing under the laws of the State of New Jersey, having its principal place of business at the city of Orange, in the county of Essex, in said State; that the respondent, Frederick I. Allen, is the Commissioner of Patents, duly qualified and acting as such, and that the said respondent was such Commissioner and acting as such on January 24,

1902, and at the time of the decisions hereinafter complained of, and is still such Commissioner. Your relator is the owner of the patents of Thomas A. Edison relating to phonographs, and it and its predecessors in interest have since 1889 been engaged in the business of selling phonographs and phonograph supplies made by the manufacturing licensee under said patents, the Edison phonograph works, and it still is so engaged.

2. Prior to May 1, 1899, the date of the filing by your relator of a petition to the Commissioner of Patents hereinafter referred to, your

relator was informed by one Leon F. Douglass of Chicago, Illinois, that he had then recently applied for a patent on an al-

2 leged invention relating to phonographs, which alleged invention consisted in operating a phonograph at a higher speed than was at that time customarily employed by users of the phonograph. The said Douglass also informed your relator at the same time that his said application for patent had become involved or was likely to become involved in an interference with an application for patent on the same invention then recently filed by Thomas H. Macdonald of Bridgeport, Connecticut, and assigned to the American Graphophone Company. Your relator at the time of receiving this information from the said Douglass had been for some time engaged in the selling of phonographs known by the trade name of "Edison concert phonograph" manufactured for it by its manufacturing licensee, the Edison phonograph works, and particularly designed to operate at this higher speed. Your relator and its said manufacturing licensee had invested a large sum of money in the said business, believing and being advised that their legal right to manufacture and sell such phonographs was beyond question, and that they were fully protected in doing so by the Edison patents which your relator owned. Your relator was further advised that no valid patent could be secured by either the said Douglass or the said Macdonald or by any other person on the said alleged invention, because the standard phonographs which had been manufactured by the said manufacturing licensee and sold by your relator and its predecessors in interest since the year 1889 had been adapted by adjustment of their speed-regulators to operate at the high speed which was claimed to constitute said alleged invention, and had been so publicly

3 operated by users of such standard phonographs and by your relator and its predecessors in interest, more than two years before the filing of applications for patents by said Douglass and Macdonald; also because the "tin foil" phonographs which had been manufactured and sold by the said Edison in the year 1877 and later had been designed to operate and had been in fact commonly and publicly operated at the said high speed; also because the said Edison made and publicly used in the year 1895 and later a machine known as the "four-hundred-thread" machine, which had been designed to operate and was commonly and publicly operated at the said high speed; also because the standard graphophones which had been manufactured by the American Graphophone Com-

pany for many years had been adapted by adjustment of their speed-regulators to operate at said high speed and had been so publicly operated by users thereof more than two years before the filing of the Douglass and Macdonald applications.

In view of these and other facts known to your relator, your relator was advised that any patent granted upon said alleged invention would not only be invalid because lacking in novelty, but also because of the statutory bar against the granting of a patent upon any invention which has been in public use or on sale more than two years prior to the filing of the application for the patent.

3. Your relator further states that notwithstanding it was advised that it could defeat any suit brought against it or its customers on any patent which might be granted either to said Douglass or said

4 Macdonald on said alleged invention, yet your relator well knew that the litigation of suits brought on such a patent would put your relator to large expense, and that the owners of such a patent could by advertising and otherwise intimidating users of your relator's phonographs, prospective purchasers of your relator's phonographs and the trade generally, greatly injure your relator's business and largely destroy the value of the investment of your relator and its manufacturing licensee in said business; and particularly that the possession of such a patent by your relator's competitor in business, the American Graphophone Company would seriously menace the business and investment of your relator and its manufacturing licensee.

Your relator was advised that the true, original and first inventor of said alleged invention was your relator's assignor, the said Thomas A. Edison, and that to prevent the grant of a patent upon the same to said Douglass or said Macdonald, it was necessary that your relator should either file an application for patent on said alleged invention in the name of said Edison and contest the question of priority of invention with said Douglass and Macdonald by an interference in the Patent Office; or that your relator should petition the Commissioner of Patents to institute public-use proceedings against the applications of said Douglass and Macdonald for the purpose of establishing the existence of the statutory bar of two years' public use against such applications. Your relator was advised, however, that the said Edison could not truthfully make the oath required on

5 the filing of an application for patent on said alleged invention, because he could not truthfully swear that said alleged invention had not been in public use or on sale more than two years prior to such application, such use having been made by your relator and said Edison, and being well known to him.

Your relator, although, by reason of its ownership, of the inventions of said Edison relating to phonographs, entitled to a patent for its own benefit upon said alleged invention if such a patent could be lawfully granted at all, yet, because of the existence of said statutory bar, your relator was prevented not only from securing such patent for its own benefit, but also from filing an application for such patent, and by means of an interference preventing either the

said Douglass or the said Macdonald from securing such patent Your relator was advised that the only lawful course open to it, to prevent the threatened grant of a patent on said alleged invention to said Douglass or Macdonald was to petition the Commissioner of Patents to institute public-use proceedings.

4. In the year 1883, there was established in the Patent Office the practice of determining by contested *inter partes* proceedings, the question as to whether or not the granting of a patent upon a pending application was barred under section 4886 of the Revised Statutes by public use in this country for two years prior to the filing of the application for patents, of the invention described and claimed in such application, when a *prima facie* case of such public use had been made out by affidavits. This practice was based upon the decision of the supreme court of the District of Columbia in *Ex parte Von Heffner-Alteneck*, which was decided in December 1882 (23 O. G., 269; C. D. 1883, p. 139), and was established by a decision of the Commissioner of Patents in the same case, dated February 6, 1883 (23 O. G., 2233; C. D. 1883 p. 33), approved by the Secretary of the Interior on appeal, April 17, 1883 (23 O. G., 2233; C. D. 1883, p. 114). The practice thus established has been followed by the Patent Office in subsequent cases. See *Ex parte Finch*, C. D. 1887, p. 96.

The practice thus established provided for a contested *inter partes* proceeding between a petitioner protesting against the granting of a patent, and showing by affidavits a *prima facie* case of public use, and the applicant for a patent, which proceeding was conducted in accordance with the practice in interference cases as defined by the rules of Practice of the Patent Office; and on points to which such rules are not applicable, in conformity as near as possible to the practice of the United States courts in equity proceedings; and included the trial of such case as a contested case before the examiner of interferences, with the right to appeal as in interference cases. That practice having been established by the Commissioner of Patents, with the approval of the Secretary of the Interior, as provided for in section 483 of the Revised Statutes, has the force of law, and is binding upon the Commissioner of Patents, making it obligatory upon him, after determining that a public-use proceeding should be instituted, to refer the papers to the examiner of interferences and have said proceeding conducted as a contested case and in accordance with the practice in interference cases.

7 V. On May 1, 1899, your relator filed with Charles H. Duell, then Commissioner of Patents, and the predecessor in office of the respondent, a petition supported by affidavits alleging that the invention sought to be patented by the applications of the said Douglass and Macdonald had been in public use in this country since the year 1877, being more than two years before the filing of the said applications, and praying that proceedings be instituted to determine the issue thus raised. A copy of said petition and accompanying affidavits is appended hereto and marked "Exhibit A." The said petition was referred to the primary examiner having

charge of the class of phonographs, and on May 11, 1899, as the result of an informal hearing before the primary examiner, your relator filed an additional affidavit of Thomas A. Edison, elaborating the facts as to one of the items of proof; a copy of which affidavit and the accompanying letter transmitting the same to the Patent Office is appended hereto and marked "Exhibit B."

6. On June 7, 1899, the primary examiner made a report on said petition to the said Charles H. Duell, Commissioner of Patents, (copy attached, marked Exhibit "C") finding that a *prima facie* case of public use had been made out, and "recommending that public-use proceedings be instituted to determine whether any device covered by Douglass' claim one has been in public use more than two years prior to Douglass' application." No reference was made in this report to the Macdonald application, although that application was referred to in said petition; but it appears by the decision of the said Charles H. Duell, dated June 30, 1899, about to be referred

8 to, that at the time the primary examiner made this report "he called the Commissioner's attention to the fact that another application, filed by Thomas H. Macdonald, disclosed substantially the same invention as that claimed by Douglass, and that one of Macdonald's claims had been suggested to Douglass, who had incorporated it in his case, and he recommended that if public-use proceedings were instituted by the Commissioner, Macdonald should be notified."

7. On June 10, 1899, the said Charles H. Duell, Commissioner of Patents, issued an order directed to said Douglass, requesting him to show cause why public-use proceedings should not be instituted against his application, the hearing on said order being fixed for June 22, 1899. A copy of said order was transmitted by letter to your relator. A copy of said order and letter is appended, and marked "Exhibit D." At the hearing on said order, counsel were heard on behalf of said Douglass, on behalf of the American Graphophone Company, the owner of the invention of the said Macdonald, and on behalf of your relator. And on June 30, 1899, the said Charles H. Duell decided that while your relator had made out a *prima facie* case for the institution of such public-use proceedings, yet on account of the pending interference between the said applications of Douglass and Macdonald, "such public-use proceedings should not be instituted until the said interference should be declared, so that the parties can inspect each other's applications, and the extent of the proceeding may be more intelligently determined;" as appears by a copy of the said decision attached hereto and marked "Exhibit E."

9 8. On July 18, 1899, the said interference between Douglass and Macdonald having proceeded to the stage contemplated by the said Commissioner in his decision of June 30, 1899, the said Commissioner instituted public-use proceedings against the Douglass application on your relator's petition, and set times for the taking of testimony. A copy of this decision was forwarded to your relator with a letter requesting your relator to furnish the

opposing parties and the Patent Office with the names and addresses of the witnesses, and the place where the examination would be conducted by your relator, and also requesting your relator to send fifty dollars to pay the expenses of the officer detailed to represent the Patent Office in conducting the proceedings. A copy of said decision of the said Commissioner, dated July 18, 1899, and the letter referred to, is appended hereto, marked "Exhibit F."

9. Your relator complied with the terms of the last-mentioned decision and letter of the said Commissioner, but before the taking of testimony had begun, further proceedings in said public-use case were suspended by the said Commissioner to await the decision in the interference case between Douglass and Macdonald.

10. On January 30, 1901, your relator having been informed that the interference between Douglass and Macdonald had been finally decided in favor of Macdonald, and being advised that the public-use proceedings directed against the application of Douglass presented only a moot question, because of the decision adverse to said

Douglass in said interference, your relator moved the said
10 Charles H. Duell, Commissioner of Patents, to reform said public-use proceedings by including the said Macdonald application therein, and further that your relator should be allowed, through its attorneys, to examine the said Macdonald application and the said interference proceedings, and be furnished by the Patent Office with copies of such portions thereof as it might desire, a copy of said motion being annexed and marked "Exhibit G." A hearing having been had upon said motion, at which all parties interested were represented by counsel, the said Charles H. Duell, Commissioner of Patents, on February 11, 1901, rendered a decision substituting the Macdonald application for the Douglass application in said public-use proceedings, but denying your relator's motion for access to and copies of the said Macdonald application and the interference proceedings. A copy of said decision of the said Commissioner is attached hereto and marked "Exhibit H."

11. Your relator thereupon filed a petition in the office of the Secretary of the Interior, praying that the decision of the Commissioner of Patents of February 11, 1901, be reviewed so far as said decision denied your relator's right to examine and take copies of the said Macdonald application and said interference proceedings. Said petition was held by the Secretary of the Interior until December 5, 1901, when it was dismissed for want of jurisdiction.

12. During the pendency of the said petition in the office of the Secretary of the Interior, the said Charles H. Duell was succeeded as Commissioner of Patents by the respondent, the said Frederick I. Allen.

Your relator, on January 2, 1902, moved the said Frederick
11 I. Allen, Commissioner of Patents, in said public-use proceedings, to transmit the Macdonald file and the other papers in said proceeding, to the examiner of interferences, with the direction to proceed with the case in accordance with the rules in interference cases, and under the practice established in the Alteneck case, a copy of said motion being annexed, and marked "Exhibit

I." At the same time, counsel for the said Macdonald moved the said Commissioner of Patents to set aside said public-use proceedings and issue the patent upon the Macdonald application. After a hearing upon both the said motions, the said Commissioner of Patents, on January 24, 1902, rendered a decision denying Macdonald's motion to issue his patent, also denying your relator's motion already referred to, and ordering that the taking of testimony in said public-use proceeding begin at a day named. A copy of said decision of the said Commissioner is attached, and marked "Exhibit J."

13. Your relator further shows that by said decision of January 24, 1902, the said Commissioner of Patents has refused to follow the practice established under the statute with the approval of the Secretary of the Interior in the Alteneck case, and has decided that the public-use proceeding against the Macdonald application based upon your relator's petition shall not be conducted as a contested case or under the rules in interference cases, but shall be conducted as an investigation in which your relator has no standing as a party, but is permitted only to furnish witnesses to the facts alleged in your relator's petition; and it further appears from said de-

12 cision that this anomalous proceeding proposed by the said Commissioner of Patents is one pending in his personal office, which is not organized as a trial court, as is the office of the examiner of interferences, but under the rules of practice is a court having appellate jurisdiction only. And it further appears that your relator, even after said testimony is furnished, may not be permitted to be represented by counsel upon the hearing upon said testimony, and will not be permitted to examine the said Macdonald application or show the pertinancy of said testimony upon the issue raised by the said proceeding, namely, whether or not the invention described in the said Macdonald application was in public use more than two years before the filing of said application, and will not have any of the other rights of a party to a contested proceeding in the Patent Office.

14. Your relator further shows that by the said decision of January 24th, 1902, a copy of which is the aforesaid Exhibit J, the said Commissioner ordered "That the taking of testimony in support of the allegation of public use begin on Monday, February 3rd, 1902, or if the witnesses cannot be produced at that time upon some day during the week then commencing, to be fixed by the protestant, and that it shall be completed with the utmost diligence. The National Phonograph Company will at once notify this office and Macdonald of the names of the witnesses and the place where they will be produced for examination during the week stated. Upon its failure to do so, it will be assumed that it is no longer willing to assist this office in the investigation, and the action upon Macdonald's application will be governed accordingly. John M. Coit, law clerk, is detailed to represent the office and conduct the proceedings."

13

Your relator further avers, upon information and belief, that this

order was sent by the said Commissioner to Leonard H. Dyer, Esquire, the Washington representative of counsel for the National Phonograph Company, by mail, and was not received by him until the 27th day of January, 1902, which was Monday. Thereupon the said Leonard H. Dyer at once communicated with Richard N. Dyer, Esquire, the patent counsel of the National Phonograph Company in the city of New York, and who had charge of said public-use proceedings for the National Phonograph Company. The said Richard N. Dyer, in consequence of illness, was unable to take immediate action with respect to the matter of the said order; but on Friday, the 31st day of January, at his instance, the said Leonard H. Dyer notified the said John M. Coit, referred to in the said order, of the illness of the said Richard N. Dyer, and that he, the said Richard N. Dyer, would call at the office of the said Commissioner on the following Monday, February 3rd, when he would inform the said Commissioner as to what action he proposed to take in the premises. On Monday, the 3rd of February, the said Richard N. Dyer accordingly called at the office of the said Commissioner of Patents, and informed him that he had consulted local counsel with respect to the rightful status of the National Phonograph Company in the pending public-use proceeding, and that the said company had retained counsel for the purpose of applying to the supreme court of the District of Columbia for a writ of mandamus to compel him, the said Commissioner, to recognize the right of the said company as an active participant in the said public-use proceeding upon the analogy of an interference proceeding, in accordance with the long-standing practice of the said office hereinbefore set forth. The said Richard N. Dyer then and there further informed the said Commissioner that a petition for the said writ was in course of preparation, and would certainly be filed within the week beginning February 3rd; further, that according to his, the said Dyer's, understanding of the said order of January 24th, the said company had the whole of the said week beginning February 3rd wherein to take action, and that he would take it for granted that if application for a mandamus were made within the said week, it would be in time to anticipate any further action of the Patent Office in the public-use proceeding. To this the Commissioner apparently assented, and remarked to the said Dyer, that "he considered the question to be raised by the mandamus proceedings a very interesting one, and one which he would like to see finally settled." Thereupon the said Dyer left the office and had no further communication with the said Commissioner. The petition for mandamus was then accordingly prepared and was taken to Orange, New Jersey, on Tuesday, the 4th of February instant, for the purpose of having the same verified by the aforesaid National Phonograph Company, which has its principal office at the said place. The aforesaid conversation between the said Commissioner and the said Richard N. Dyer occurred in the presence of the said Leonard H. Dyer, whose affidavit to that effect, together with the affidavit of the said Richard N. Dyer, is herewith filed, marked Exhibit K.

15 15. And the relator further shows to the court, upon information and belief, that nothing further was heard either from the said Commissioner or from the said Coit until Thursday, the 6th day of February instant, when the said Leonard H. Dyer received through the mail from the said Commissioner of Patents what purported to be a copy of an order issued by the said Commissioner, and which, after reciting the language of the aforesaid order of January 24th, 1902, to the following effect:

“The National Phonograph Company will at once notify this office and Macdonald of the names of the witnesses and the place where they will be produced for examination during the week stated. Upon its failure to do so, it will be assumed that it is no longer willing to assist this office in the investigation, and the action upon Macdonald's application will be governed accordingly,” proceeded as follows:

“The National Phonograph Company has not complied with this order; and since it is apparently not willing to produce the witnesses to the alleged public use for examination, a continuation of the investigation is impractical. The order constituting the public-use proceeding is set aside, and Macdonald's application is remanded to the primary examiner for consideration and action.

F. I. ALLEN,
Commissioner.

February 5, 1902.”

All of which will more fully appear from the copy of the said order marked Exhibit L which is herewith filed, and prayed to be read as part hereof.

16 16. While your relator does not intend to charge the said Commissioner with any fraudulent intent or wrongful purpose in issuing the said order last hereinbefore referred to, nevertheless he does aver that the issuance of the said order under the circumstances hereinbefore set forth, and especially in view of the words uttered by the said Commissioner in reply to the statement that mandamus proceedings were contemplated, and that the papers concerning the same were in preparation for filing, constitute a fraud in law upon the rights of your relator, and an attempt to deprive your relator of legal rights which had been constituted by the declaration of the aforesaid public-use proceedings, and of which he cannot be divested by the aforesaid *ex parte*, arbitrary and illegal order of the said Commissioner.

17. Your relator further charges that he has no relief in the premises save by a writ of mandamus, and that as he is advised by counsel an appeal or a writ of error will not lie from the action of the said Commissioner, respondent, to any superior tribunal. Further, your relator shows that the action of the said respondent in the premises is a matter of public concern, and one occurring in the administration of justice. Your relator therefore prays that this honorable court will, by its writ of mandamus, command the said respondent the said Frederick I. Allen, Commissioner of Patents as aforesaid,

to forthwith reinstate the aforesaid public-use proceeding, and having so done to grant to your relator the rights of a party in interest in said public-use proceeding, and to conduct said proceeding as a contested case under the practice prevailing in the aforesaid office, in accordance with the decision in the Alteneck case hereinbefore referred to.

NATIONAL PHONOGRAPH CO.,
By WILLIAM E. GILMORE, [SEAL.]
President.

LEONARD H. DYER,
RICH'D N. DYER,
R. ROSS PERRY AND SON,
Attorneys for Relator.

DISTRICT OF COLUMBIA, ss :

I, William E. Gilmore, do solemnly swear that I am the same person who has signed the foregoing petition as president of The National Phonograph Company, the relator therein, and that I am such president and have authority from the said corporation to sign the said petition and verify the same; further, that I have read the foregoing petition, and know the contents thereof; that the matters therein stated of my own knowledge are true, and that those therein stated on information and belief I believe to be true. Further, that the corporate seal hereto attached is the true corporate seal of the said relator, The National Phonograph Company.

WILLIAM E. GILMORE.

Subscribed and sworn to before me this 7th day of February, A. D. 1902.

J. R. YOUNG, *Clerk*,
By L. P. WILLIAMS, *Ass't Cl'k.*

18 EXHIBIT A.

Filed February 7, 1902.

In the United States Patent Office.

In the Matter of the Application of the National Phonograph Company of Orange, New Jersey, Requesting the Institution of Public-use Proceedings. On Petition. No. 45225.

To the honorable Commissioner of Patents:

Your petitioner, National Phonograph Company, respectfully represents:

1. Your petitioner is a corporation organized under the laws of the State of New Jersey, having its principal place of business at Orange, in the county of Essex, in said State.

2. Your petitioner is the owner of the patents of Thomas A. Edison relating to phonographs, and it and its predecessors in interest

have since 1889 been engaged in the business of selling phonographs and phonograph supplies made by the manufacturing licensee under said patents, the Edison phonograph works.

3. Your petitioner is at the present time engaged in the sale of concert phonographs made by its licensee the Edison phonograph works, and wherein is used a soap blank having a diameter of five inches, a length of 4.25 inches and operated at a normal shaft speed of from one hundred to one hundred and twenty turns per minute, thus giving the surface speed to the blank ranging from 1570.8
19 to 1884.96 inches per minute.

4. Your petitioner is informed and believes that certain of its competitors or their assignors are seeking to secure a patent on a phonograph employing a waxlike record blank of an abnormally large diameter operated at or about the usual shaft speed of from 100 to 120 turns per minute, whereby a greater surface speed will be secured than is usually employed in the operation of the Standard phonographs at a corresponding shaft speed, the increased surface speed so obtained necessarily resulting in louder and clearer reproduction.

5. Your petitioner respectfully represents that the grant of a patent on a phonograph, employing a large blank operated at approximately the usual shaft speed, would result in the subjection of your petitioner to the possibility of a suit for infringement, thereby putting your petitioner to great annoyance and expense, and to possible irreparable injury.

6. Your petitioner respectfully represents that from the affidavits of Thomas A. Edison, William E. Gilmore, Walter H. Miller, Charles Wurth and John F. Ott filed herewith and made a part hereof, it appears to have been well recognized in the phonographic art that the advantages resulting from the use of high surface speed of phonograph blanks were recognized as early as 1877, and that phonograph blanks have been made of varying diameters and have been operated at varying shaft speeds with the point in view of securing superior reproduction both in loudness and clearness.

20 7. Your petitioner respectfully represents that in view of the public knowledge indicated by these affidavits, a patent on a phonograph having a large waxlike blank operated at or about the usual shaft speed should not be granted by the Patent Office, as it clearly covers only the recognized knowledge of a skilled person and does not cover a patentable invention.

8. Your petitioner furthermore represents that from the affidavits in question, it appears that phonographs using record blanks ranging from six and one-half to seven inches and operated at shaft speeds of about one hundred and twenty-five rotations per minute were made and sold in this country, and were in public use in this country at as early a date as 1877, and that phonographs having waxlike record blanks capable of being operated at a high surface speed have been made and sold in this country and have been in public use in this country for more than ten years. Said affidavits also show that as early as 1896, a phonograph using wax-like record

blanks having a diameter of seven inches and operated at a shaft speed of one hundred and twenty-five rotations per minute, was made and exhibited in this country and was witnessed by a large number of persons.

Wherefore, your petitioner prays:

1. That proceedings may be instituted by the Patent Office, but at the expense of your petitioner, to determine the truth of the facts above presented, and of the facts alleged in the affidavits in question, in order that such information may be brought properly
21 to the attention of the Patent Office as will show not only that a claim on a phonograph employing a large wax-like blank operated at approximately the usual shaft speed, is unpatentable, but that it covers apparatus which has been long in public use.

2. If a novelty of a proceeding to investigate the state of the art, in addition to determining the question of public use, is considered a reason for the refusal of such an inquiry as above requested, then your petitioner requests that the office may institute public-use proceedings in connection with this matter to determine the truth of the assertion above made and contained in said affidavits, that as a matter of fact, phonographs *have* abnormally large blanks operated at approximately the usual shaft speed, and phonographs having wax-like blanks operated at very high surface speeds, have been in public use and on sale and have been used and sold in this country for more than ten years past.

3. Your petitioner respectfully requests that the office may designate as persons, by whom the testimony as to public use or as to public use and prior knowledge is to be taken, its attorneys, Messrs. Dyer, Edmonds & Dyer, a firm composed of Richard N. Dyer, Samuel O. Edmonds and Frank L. Dyer of No. 31 Nassau street, New York city.

4. It is requested as a matter of right and fairness, that full opportunity be given any person directly interested in the determination of these questions to cross-examine any witnesses who may be produced, due notice of the examination of such witnesses to be given to such opposing parties.

22 And your petitioner will ever pray, &c.

Respectfully,

NATIONAL PHONOGRAPH COMPANY,
By WALTER S. MALLORY, *President*.

STATE OF NEW JERSEY, }
County of Essex, } ss:

Walter S. Mallory, having been duly sworn, on oath doth depose and say, that he is president of the National Phonograph Company, the petitioner above named; that he has read the above petition, and that the same is true of his own knowledge except as to such matters as are stated on information and belief, and as to such matters he believes it to be true.

WALTER S. MALLORY.

Subscribed and sworn to before me this 14th day of April, 1899.

J. F. RANDOLPH,

[SEAL.]

Notary Public for New Jersey.

23

Affidavit of William E. Gilmore.

In the United States Patent Office.

In the Matter of the Application of The National Phonograph Company of Orange, New Jersey, Requesting the Institution of Public-use Proceedings. On Petition.

STATE OF NEW JERSEY, }
County of Essex, } ss:

William E. Gilmore, being first duly sworn, on oath doth depose and say as follows;

I am the general manager of the National Phonograph Company, the above-named petitioner, which company is the owner of the patents of Thomas A. Edison relating to phonographs, and is engaged in the sale of phonographs made by its licensee the Edison Phonograph Works, and in the commercial exploitation of the phonograph. On March 16, 1899, Leon F. Douglass of Chicago, Illinois, called at my office at Orange, New Jersey, and informed me that he had filed an application for a patent on a phonograph having a wax-like record blank of abnormally large diameter, operated at the usual shaft speed of from 100 to 120 turns per minute; that on such machine a claim had been allowed by the Patent Office; but that the said application had become involved in an interference controversy with an application for the same device, filed by Thomas H. Macdonald, and assigned to the American Graphophone Company. This information was communicated to me by Mr. Douglass freely, without reservation and without any conditions whatever. In this interview,

24 Mr. Douglass showed me a paper which he stated was a copy of the specification and claims forming a part of his said application; and particularly identified the claim which he informed me had been allowed by the Patent Office. I thereupon requested Mr. Douglass to permit me to copy the said allowed claim, which request was granted absolutely and without condition. In the presence of Mr. Douglass and in conformity with his offer, I then made a shorthand copy of said allowed claim and immediately transcribed my shorthand notes. The said claim which Mr. Douglass informed me was allowed by the Patent Office, is as follows:

"The combination with a large sound-record blank or cylinder of a wax-like composition, of, say, substantially six inches in diameter, of a talking instrument and a motor for rotating the large sound-record cylinder or blank at the usual or customary speed of 100 or 120 revolutions per minute, whereby the volume, clearness, distinctness and naturalness of the speech, vocal music, instrumental music

or other sounds recorded or reproduced are greatly increased, substantially as specified."

WILLIAM E. GILMORE.

Sworn to before me this 14th day of April, 1899.

J. F. RANDOLPH,
Notary Public for New Jersey.

25

Affidavit of Thomas A. Edison.

In the United States Patent Office.

In the Matter of the Application of the National Phonograph Company of Orange, New Jersey, Requesting the Institution of Public-use Proceedings. On Petition.

STATE OF NEW JERSEY, }
County of Essex, } ss:

Thomas A. Edison, being duly sworn, on oath doth depose and say as follows:

I am the inventor of the phonograph. The phonograph as devised by me in 1877 and manufactured and sold during succeeding years comprised, in the large machine, a cylinder about $6\frac{1}{2}$ inches in diameter, mounted on a shaft having a thread cut on a portion of its length and a handle at the other end for rotating it. A diaphragm was used, carrying a chisel point. A groove was generally cut in the periphery of the cylinder, corresponding in pitch to the screw on the shaft, the latter engaging with a stationary nut, whereby when the shaft was rotated the cylinder would be moved laterally with respect to the chisel point on the diaphragm. With the original phonographs, the customary practice was to cover the cylinder with a sheet of tinfoil, on which would be recorded the vibrations of the diaphragm. The construction and operation of the original phonograph are familiar to most persons and have been described in many text books, publications and patents. The usual shaft

26 speed of the original phonograph was about 125 turns per minute, giving a surface speed of the recording surface of not far from 2,500 inches per minute. With a surface speed of this rate, ample opportunity was given for the distinct formation of the irregularities of the record, irrespective of pitch, and in consequence, the reproductions of the original phonograph were extremely loud, much louder, in fact, than any phonograph at present on the market. As a matter of fact, the original phonograph was designed essentially as a talking machine and was used almost entirely for exhibition purposes, its reproductions being sufficient to be heard easily throughout the entire portion of large halls, lecture-rooms and other auditoriums.

Since with all phonographs and other talking machines operated upon the same principle, the record is formed by the production in or upon the recording surface of waves or depressions correspond-

ing to the original vibrations, I found as early as 1877, from experiment and microscopical examinations, that these waves or depressions would be formed more perfectly and that the reproduction would be better and louder, if they were allowed to extend over a relatively great length of surface. Consequently, I made my original phonograph with a large blank and a high surface speed, because I wanted to secure an instrument capable of loud reproduction and suited for exhibition purposes.

About the year 1887, the original graphophones were put on the market. In these machines, paper blanks having a waxlike coating were used, the blanks being 1.25 inches in diameter and 6 inches long, with a pitch of 160 threads per inch and a usual
27 shaft speed of about 200 turns per minute. At this shaft speed, the surface speed of these blanks was 785.4 inches per minute, somewhat lower than that used in the present Standard phonographs, while the length of the record groove was 3,769.92 inches. Owing to the low surface speed, to the objectionable character of the recording surface, and to the crudeness of the recording and reproducing devices, the reproductions secured with the old graphophones were very faint and obscure.

Prior to 1887, I continued the experiments which had been conducted by me at the time of the invention of the original phonograph in the use of recording surfaces of a waxlike material, and as a result of these experiments I invented the present recording cylinders, composed of an amorphous, coherent, hard, brittle, non-viscid material, such as a metallic soap. These experiments resulted, also, in the production of the modern commercial phonograph, with its detailed improvements relating to the recording and reproducing devices, its general make-up, motor, governor &c. By reason of these improvements, in the character of the record surfaces and in the construction of the recording and reproducing devices, and furthermore, by using separate and distinct recording and reproducing devices, each fitted particularly for its special work, the loudness and clearness of the records and the durability of such records were very greatly advanced.

In 1887, I adopted the present standard-size phonograph blank, of an external diameter of 2.1875 inches, a length of 4.25 inches, and with a pitch of 100 per inch. My reasons for adopting a standard blank of this size were that it presented in a minimum
28 bulk a sufficient area for the making of a phonograph record of average length, without necessitating too fine a pitch as to be liable to become injured in the exigencies of use by more or less unskilled persons. A blank of this size enabled me to make my phonographs of a neat and substantial construction, while the blanks were of sufficient mass as to be strong enough to withstand the ordinary usage. I designed the Standard phonographs particularly for office work in the dictation of correspondence, and having adopted, for the more or less arbitrary reasons stated, a blank of the size indicated, I found that by turning it at a speed of about 100 rotations per minute I was enabled to secure records of

letters of an average length, which records could be reproduced clearly and satisfactorily by the employment of listening tubes. When used with listening tubes, the records secured on the standard blanks operated at a shaft speed of about 120 turns per minute, were, and are still, sufficiently loud for the purposes for which these machines were particularly designed.

The perfected Standard phonographs were first brought out about the year 1889, and were provided with electric motors having centrifugal governing devices, by which the surface speed of the blank could be varied within wide limits, or, in other words, from about 50 to 300 rotations per minute. The standard-sized phonograph blanks adopted by me in 1887, with a pitch of 100 threads per inch and a usual shaft speed of about 120 turns per minute, have been adopted by my competitors in the phonograph business and now constitute the usual standard in this art.

In September, 1888, I commenced the manufacture of doll phonographs having soap record blanks 3 inches in diameter, adapted to be operated at a shaft speed of about 120 turns. These phonographs were made and sold in 1888 and subsequently thereto.

The increase in the diameter of the phonographs from 2.1875 inches to 3 inches resulted in an increase in the surface speed of from 824.67 to 1130.976 inches per minute. These doll phonographs were capable of reproducing, and did reproduce, loudly, but owing to the fact that the reproducing device used with them was cheap and simple, the reproduction was not as clear as it would have been if the present floating-weight reproducer had been used.

In 1890, I constructed a large number of phonographs of the type described in my patent No. 610,706, dated September 13, 1898, which instruments were shipped to Great Britain. With these machines, a standard soap blank was ordinarily used, but the machine was adapted to receive a small mailing blank only .75 inches in diameter, with a length of 3.875 inches. For the making of commercial records adapted to be transcribed on the typewriter, the standard blank was used, the reproductions through the listening tubes being loud enough and clear enough for this purpose, while for mailing purposes the records were produced on the small blanks for transmission through the mails and the reproduction was sufficiently loud and clear through the listening tubes as to suit the purposes of private, confidential correspondence. With these machines, the reproduction was always superior, both in loudness and quality, with the standard blanks than with the mailing blanks, the shaft speed in each instance being assumed to be the same, since the surface speed of the former (824.67 inches) was almost three times that of the latter (282.744 inches).

In 1895, I constructed at my laboratory at Orange, N. J., a machine of a new type, which I call my "400-thread machine," and which has been viewed and examined by a large number of persons. In this machine, a phonogram 2.75 inches in diameter and 6.50 inches in length is employed. By a change in the gearing, the pitch of the record grooves has been varied to from

200 to 320 and to 400 threads per inch ; the shaft speed has varied from 150 to 250 turns per minute, but has almost always, in my experiments, been confined to about 200 turns per minute, giving a surface speed of the record surface of 1727.88 inches per minute, or more than double that of the standard blank at 120 revolutions per minute. By reason of the increased surface speed, the reproductions have been of a very superior order, both in loudness and quality, while by reason of the fineness in pitch, the phonograms are adapted for the reception of records of unusual lengths. The 400-thread machine is at present in use in my laboratory, records are frequently made thereon and visitors are allowed the opportunity of hearing its reproductions.

In March, 1896, in order that the capacity of my old tinfoil phonograph for use with soap blanks might be determined, I made a number of soap blanks, having an external diameter of 7 inches and a length of two inches, which were placed on the old tinfoil machines and records secured thereon, the pitch being, as originally, 25 threads per inch and the speed being 125 turns per minute. With a blank of this diameter and at the shaft speed indicated, a surface speed of 2748.9 inches per minute was secured, a higher speed than any used at the present time. With the tinfoil machine having a soap blank, the chisel point served to cut or gouge out a record, in

the same way as in the modern instruments. The reproductions secured was extremely loud in character, although the clearness of the reproduction was necessarily limited by reason of the crudeness of the machine and of the fact that the recording device was also used in effecting the reproduction. So far as I know, these blanks which were made by me in 1896, having a diameter of 7 inches, were the largest phonograms which have ever been made and exhibited. The mold in which these blanks were made is still in my possession.

After the Standard phonographs were brought out by me in 1889, a public demand arose for musical records, and at the present time the phonographs are used almost entirely for this purpose. With standard blanks operated at a shaft speed of about 120 turns per minute, I found that a record groove of sufficient length was secured to enable ordinary musical compositions to be recorded, and when the reproduction was heard through listening tubes it was entirely satisfactory. The demand of the public has, however, during recent years, been towards the production of a phonograph for exhibition purposes wherein the reproductions of intricate musical compositions would be heard through a horn, and to this end, therefore, it became necessary to make a phonograph which, while having a sufficiently high surface speed, would have a record groove long enough for an ordinary musical composition. I, therefore, determined to go back to my original experiments with the tinfoil phonograph, and to make a phonograph having a sufficiently large blank as to secure a high surface speed. At the present time, the National Phonograph Company, in which I am interested, is making and selling machines called the "Concert phonographs," using a soap blank of 5

32 inches in diameter, 4.25 inches in length, with a pitch of 100 threads per inch, and operated at a shaft speed of from 100 to 120 turns per minute. With these machines, a surface speed ranging from 1570.8 to 1884.96 inches per minute is attained. At a shaft speed of 100 turns per minute, the surface speed of the Concert phonograph blank is less than that of the blank used by me on the 400-thread machine in 1895 and during the succeeding years, while at 120 turns per minute, the surface speed is more. By reason of the high surface-speed and of the character of the blank and recording and reproducing devices, the reproduction obtained with the Concert phonograph is very loud and clear. These machines are, therefore, adapted for exhibition purposes, in reproducing music with a horn.

I have known since 1877 that the loudness and clearness of the reproduction depends upon the surface speed of the blank, other conditions of construction and operation being the same, and when the surface speed of one blank exceeds that of another, it may be assumed, other conditions being equal, that the reproduction of the former will be better than that of the latter. I have demonstrated this by operating a Standard phonograph at a surface speed higher than that of the Concert phonograph, in which case the reproduction of the standard machine was superior in loudness and clearness to that of the concert machine.

I am informed and believe that my competitors in business are seeking to secure a patent on a phonograph having a waxlike blank of an abnormally large diameter and operated at the usual shaft speed of 100 to 120 turns per minute, whereby a higher surface speed is secured than in the Standard phonograph operated at the same shaft speed. In this way, an increase in the surface speed
33 will be secured, with a consequent louder and clearer reproduction. I am unable to see upon what theory a patent can be now secured on a phonograph having a large blank operated at the usual shaft speed, in view of my work in the art, both theoretically and in practice. Since 1877 I have known that an increase in the surface speed in a given machine resulted in better reproduction. This is demonstrated as a matter of fact by the use by me of blanks for mailing purposes having a diameter of only .75 inches, where the reproduction should be, and is, only loud enough for private conversational purposes when listening tubes are used; in the use of blanks for doll phonographs having a diameter of 3 inches, with a surface speed of 1130.976, where the reproduction should be loud enough to make a doll a salable thing on the market; in the 400-thread machine, where a blank of 2.75 inches is operated at a surface speed of 1727.88; in the Concert phonograph, where a blank of 5 inches is operated at surface speeds ranging from 1570.8 to 1884.96; and in the old tinfoil machines (with tinfoil and soap blanks), where a blank ranging from 6.5 to 7.0 inches was operated at a surface speed of 2748.9. Furthermore, since I have operated phonograph blanks in practice and have sold phonographs wherein the blanks were operated at surface speeds ranging from 282.744

inches per minute in the mailing machine, up to 2748.9 in the tin-foil machine, with tinfoil records and soap-records, I do not see upon what theory a patent can be granted covering the operation of a blank at a speed intermediate of those extremes. Furthermore, since Standard phonographs have been made and sold since 1889 with records capable of operation at widely different surface speeds,

I do not believe that a patent should now be granted on a
34 blank operated at a surface speed of which the standard machine is capable. Finally, since I have operated the 400-thread machine in the presence of many visitors to my laboratory at a surface speed of 1727.88 inches per minute, I do not believe that a patent should now be granted upon a phonograph wherein the blank is operated at a surface speed of only 1884.96 inches per minute, an increase of but a slight extent, assuming the blank for which a patent is being sought to have a diameter of 6 inches, a length of 4.25 inches and a pitch of 100 threads per inch.

In order that a clear comprehension of this subject may be secured, I have prepared a table, which I attach hereto, giving the diameter, the length, the pitch, the shaft speed, the surface speed and the length of the record groove in the eight types of phonographs or graphophones to which I have referred herein, arranged in the order of the diameter of the blanks. From this table, it will be observed that the surface speed of the large-blank machine for which a patent is sought is slightly greater than that of the 400-thread machine, which in turn is slightly greater than that of the Concert phonograph operated at 120 turns per minute, while the length of the record groove of the large-blank machine (which factor determines the quantity of the record composition) is about 20 % more than that of the Concert phonograph, but greatly below that of the 400-thread machine.

So far as I can determine, the phonograph for which a patent is being sought makes use of the ordinary soap blanks, which have
35 been used on the Standard phonographs since 1889, while an increase in the surface speed is secured in the same way as in the old tinfoil machines, by using a blank of a large diameter.

THOMAS A. EDISON.

Subscribed and sworn to before me this 15th day of April, 1899.

J. F. RANDOLPH,
Notary Public for New Jersey.

36 Type.	Diameter.	Length.	Pitch.	Shaft speed.	Surface speed.	Length of record groove.	Remarks.
Mailing	.75	3.875	100	120	282,744	913.0275	Made and sold in 1890 and covered in double-blank patent No. 610,706.
Old graphophone...	1.25	6.	160	200	785.4	3769.92	Put on the market about 1887. Surface speed lower than any subsequent machine, except mailing-blank phonograph.
Standard	2.1875	4.25	100	120	824.67	2920.70625	Adopted 1887 and put on the market in 1889. By doubling speed, surface speed 1649.34. Maximum shaft speed about 300.
400-thread	2.75	6.50	200	200	1727.88	#1. = 11231.22	} Made in 1895. Surface speed <i>between</i> Concert phonograph at 100 and 120.
			320			#2. = 17969.952	
			400			#3. = 22463.44	
Doll	3.	.75	100	120	1130.976	706.86	Started Sept. 19, 1888. Surface speed somewhat higher than Standard at equivalent shaft speed.
Concert	5.	4.25	100	100	1570.08		} At 100 less than 400 thread, and 120 at more than same.
				120	1884.96	6675.9	
							
Large-blank phonograph	6.	4.25	100	100	1884.96		} Surface speed intermediate of lowest (282.744) and highest (2748.9) of actual tests. At 10° rev. within 10% of 400-thread machine, while within 20% of Concert. Length of record, only about 75% (200 pitch), about 45% (320 pitch) and about 37% (400 pitch) of 400-thread machine.
				120	2261.952	8011.08	
							
Tinfoil	7.	2.	25	125	2748.9	1099.56	The surface speed has therefore in actual work been far exceeded, and in one instance approached within 10%; while in length of record, it has also been greatly exceeded, and in one instance approached within 25%. Concerning its resemblance to the Concert machine (speed the same) the relative surface speeds and lengths of record grooves are not within 20%. Made in 1896 with wax blanks. Surface speed from 25% to 50% <i>higher</i> than that of large-blank machine.

37

Affidavit of Walter H. Miller.

In the United States Patent Office.

In the Matter of the Application of the National Phonograph Company of Orange, New Jersey, Requesting the Institution of Public-use Proceedings. On Petition.

STATE OF NEW JERSEY, }
County of Essex, } ss :

Walter H. Miller, being duly sworn, on oath doth depose and say as follows:—

I am in the employ of the National Phonograph Company, and since 1887 my time has been almost entirely consumed in the making of experiments in connection with phonographs and in practical and commercial work therewith. I have made many thousand phonographic records and have reproduced them, including the making and reproduction of musical records.

In the operation of the phonograph I observed from the commencement of my association with this work in 1887 that with the same recording and reproducing instrumentalities the loudness and quality of musical reproduction are affected by the surface speed at which the blank is operated. At the present time I am engaged in the making of musical records for the Concert phonograph, which machine makes use of a blank having a diameter of 5 inches, a length of 4.25 inches, a pitch of 100 threads per inch, and a shaft speed of from 100 to 120 revolutions per minute. With this machine the records are louder and clearer than with the ordi-

38 nary standard machine having a blank of 2.1875 inches, owing to the increase in the surface speed, since in the character of the recording surfaces and of the recording and reproducing devices, the two machines may be assumed to be equal.

In order to satisfy myself that the pitch and quality of a musical reproduction is affected by the surface speed of the blank, other conditions being the same, I have recently made the following experiment: I secured a song record of the human voice on a Concert phonograph operating at a surface speed of between 1570.8 and 1884.96, and a corresponding record of the same song produced by the same voice on a Standard phonograph blank having a diameter of 2.1875 and operated at substantially the same surface speed. When the two records were reproduced, I found that the reproduction could not be distinguished one from the other, and that the reproduction on the standard blank was equal in every respect, and certainly in loudness and quality, to the record, on the concert blank, having more than double the diameter of the standard blank.

I am familiar with the original Edison phonograph using a tin-foil record surface, and with the public experiments made by Mr. Edison in the use of a soap blank 7 inches in diameter with the

original tinfoil machine. This soap blank was used by Mr. Edison in March, 1896, and was operated at a shaft speed of about 125 turns per minute, giving a surface speed of the blank of 2748.9 inches per minute. Owing to the high surface speed of the old tinfoil phonograph and of the tinfoil phonograph using a soap blank, the reproduction secured was very loud.

WALTER H. MILLER.

Subscribed and sworn to before me this 15th day of April, 1899.

J. F. RANDOLPH,

Notary Public of New Jersey.

[SEAL.]

40

Affidavit of Charles Wurth.

In the United States Patent Office.

In the Matter of the Application of The National Phonograph Company of Orange, New Jersey, Requesting the Institution of Public-use Proceedings. On Petition.

STATE OF NEW JERSEY, }
County of Essex. }

Charles Wurth, being duly sworn, on oath doth depose and say as follows:

I am in the employ of Thomas A. Edison. I entered Mr. Edison's laboratory in 1888, and since that time have been employed continuously in making experiments in connection with phonographs and in practical and commercial work therewith. During that time I have made many thousand original and duplicate records, including musical compositions. Since my entrance into the Edison laboratory I have observed that the loudness and quality of phonographic musical records are determined by the surface speed of the recording surface, it being assumed that other conditions are equal, and that by increasing the surface speed of a phonograph the reproduction will be louder and clearer.

Prior to 1890 I operated the old Edison tinfoil machines, wherein the recording surface was more than six inches in diameter, and found that owing to the high surface speed the reproduction was very loud. As, however, these machines used tinfoil record blanks and crude and imperfect single recording and reproducing devices, the reproduction was not so clear as it is now possible to make it with the modern soap blanks and by using the perfected separate recording and reproducing devices. I witnessed the operation of one of the old tinfoil machines with wax blanks in March 1896, and observed that owing to the high surface speed the reproduction secured was of great loudness and of better quality than when operated at a slower surface speed. I have operated many of the Standard phonographs at varying surface speeds, always with the result of securing better results both as to loudness and

41

quality when the surface speed was increased, other conditions being the same.

In the years 1894 and 1895 I conducted experiments with Standard phonographs employing blanks having a diameter of 2.1875 and a length of 4.25, at speeds varying from 150 to 250 revolutions per minute, and in every instance found that the high surface speed rendered the musical reproduction superior in loudness and quality. In these experiments the pitch of the feed was varied from 200 to 300, to 320 and to 400 threads per inch respectively, in order that the same or a longer record groove might be secured with a standard blank operated at the abnormally high speeds indicated.

In 1895 a machine was constructed at the Edison laboratory for the use of blanks having a diameter of 2.75 and a length of 6.50. These blanks were operated by me at that time, and have since been operated at a speed of about 200 revolutions per minute with pitches varying from 200 to 320 and to 400 threads per inch. With this

42 machine I found that the increased surface speed, due both to the increase in the diameter of the blank and to the higher shaft speed, resulted in a corresponding increase in the loudness and clearness of the musical reproduction.

I have often heard reproductions of musical records secured with the new Concert phonograph now made by the Edison phonograph works and sold by the National Phonograph Company and using blanks having a diameter of 5 inches, with a length of 4.25 inches, pitch of 100 threads, and a shaft speed of from 100 to 120 revolutions per minute. The superior loudness and clearness of the reproductions of the Concert phonograph are due to the increased surface speed, other conditions, such as the character of the blanks, construction of recording and reproducing devices, volume and quality of the original sounds, skill of the operators, acoustic properties of the rooms in which the records are secured and reproduced, and all other factors which determine or affect the recording or reproduction, being assumed to be the same. I have secured just as good results, both as to clearness and loudness, with the Standard phonograph operated at a correspondingly high surface speed, and at least in point of clearness, with the 400-thread machine when so operated. These results, both with the Standard machine and with the 400-thread machine, were secured by me in 1894 and 1895 with the former, and in 1895 and subsequently with the latter, apparatus.

CHAS. WURTH.

Subscribed and sworn to before me this 14th day of April, 1899.

[SEAL.]

J. F. RANDOLPH,
Notary Public for New Jersey.

In the United States Patent Office.

In the Matter of the Application of the National Phonograph Company of Orange, New Jersey, Requesting the Institution of Public-use Proceedings. On Petition.

STATE OF NEW JERSEY, }
County of Essex, } ss:

John F. Ott, being duly sworn, on oath doth depose and say as follows:

I was a laboratory assistant of Mr. Edison at the time the phonograph was invented by him in 1877, and have been in his employ continuously since that time. I am familiar with the construction and operation of phonographs, and have witnessed the gradual evolution of that instrument from the original tinfoil machine to the present Standard type of apparatus. I have read the affidavit of Mr. Edison relating to this matter and subscribed by him on the 15th day of April 1899, and can verify all the facts to which he refers.

It was observed by all of us in the laboratory, when the phonograph was originally invented and when the very early experiments were made with it in 1877, that by changing the surface speed of the recording surface the loudness and clearness of the reproduction would be correspondingly increased. We observed that by turning the crank slowly the reproduction was poor and faint, while
44 by turning it at a higher speed the reproduction could be made louder and clearer. The same was true with the Standard phonograph with which experiments have been made by me in 1887 and during the succeeding years. With the Standard phonograph the blank was rotated by a suitable electric, spring or water motor, and which in every instance was capable of variations in speed within wide limits. I have frequently observed that by operating these machines at a slow speed the reproduction was less perfect than when operated at a higher speed.

Phonographs were made for use with dolls in 1888, having cylinders 3 inches in diameter and operated at a shaft speed of 120 revolutions. The increase in diameter of these blanks over the Standard type of 2.1875 resulted in a higher surface speed with a corresponding increase in the loudness of the reproduction.

In 1895 a machine was constructed at the laboratory, known as the "400-thread machine," having a cylinder 2.75 inches in diameter and 6.5 inches in length, operated at a shaft speed of 200 turns per minute. By reason of the relatively high surface speed of the blanks used on the 400-thread machine, the reproduction secured was very loud and clear.

The Standard phonographs which were put on the market and sold in 1889 and during the succeeding years, were intended

originally for office work in the dictation of correspondence etc. The demand of the public, however, tended towards the recording and reproducing of music, in some instances of a very intricate character. The Standard phonographs were intended for use principally with listening tubes, and when so used, the reproductions, either of spoken words or of music, were loud enough for the purpose. At the present time, however, the demand is for a machine capable of reproducing music with a horn, and which in consequence must have a high surface speed. The National Phonograph Company in order to meet this requirement, is at the present time making and selling machines called Concert phonographs, wherein blanks 5 inches in diameter are used. By reason of the high surface speed secured with these blanks, the reproductions are loud and clear enough for exhibition purposes with a horn.

JOHN F. OTT.

Subscribed and sworn to before me this 14th day of April, 1899.

[SEAL.]

J. F. RANDOLPH,
Notary Public for New Jersey.

46

EXHIBIT B.

Filed February 7, 1902.

In the United States Patent Office.

In the Matter of the Application of the National Phonograph Company of Orange, New Jersey, Requesting the Institution of Public-use Proceedings. On Petition.

Honorable Commissioner of Patents.

SIR: In accordance with the request of the examiner, division 23, we file herewith an additional affidavit of Mr. Edison in the above matter, which we request may be attached to the other affidavits already on file.

Very respectfully,

DYER, EDMONDS & DYER,
Attorneys for National Phonograph Company.

New York city, May 10, 1899.

47 *2nd Affidavit of Thomas A. Edison.*

In the United States Patent Office.

In the Matter of the Application of the National Phonograph Company of Orange, New Jersey, Requesting the Institution of Public-use Proceedings. On Petition.

STATE OF NEW JERSEY, { ss:
County of Essex, }

Thomas A. Edison, being duly sworn, on oath doth depose and say as follows:

I have already made an affidavit in this case relating to my work in the phonographic art, which affidavit was signed and executed April 15, 1899.

The 400-thread machine which I refer to in my first affidavit and which was made in 1895, was publicly exhibited in my laboratory in 1895 and during the succeeding years. The reproductions of musical records on that machine have been listened to by a large number of visitors to my laboratory in the year 1895 and during the succeeding years. The machine is still in my possession and in practically daily use, and many visitors to my laboratory at the present time are permitted to witness its operation and to listen to its reproductions. I believe that if this machine were sent to Washington at the present time for inspection by the examiner, and were then returned by him for use in the taking of testimony should the request for the institution of these proceedings be granted,
48 there would be danger of the machine becoming damaged in transportation.

THOMAS A. EDISON.

Sworn to and subscribed before me this eighth day of May, 1899.

[SEAL.]

J. F. RANDOLPH,
Notary Public for New Jersey.

49 EXHIBIT C.

Filed February 7, 1902.

WASHINGTON, D. C., June 7, 1899.

Honorable Commissioner of Patents.

SIR: Leon F. Douglass has filed an application for a patent on talking machines and the following claim of said application has been allowed:

"The combination with a large sound record blank or cylinder of a waxlike composition of say substantially six inches in diameter, of a talking instrument and a motor for rotating the large sound record cylinder or blank at the usual or customary speed of one hundred or one hundred and twenty revolutions per minute, whereby

the volume, clearness, distinctness and naturalness of the speech, vocal music, instrumental music or other sounds recorded or reproduced are greatly increased, substantially as specified."

It appears from an affidavit of William E. Gilmore, which I send you herewith, that Douglass has voluntarily shown him this allowed claim. Gilmore appears to be the general manager of the National Phonograph Co., and said company has filed a protest through their attorneys Messrs. Dyer, Edmonds and Dyer, and several affidavits, which are also sent herewith, protesting against the grant of a patent to Douglass on the grounds, first that in view of certain facts well known to Mr. T. A. Edison and others, and which facts had
50 long been established by them in their labors in connection with the phonograph, that there is nothing patentable in Douglass' claim; and second, that the invention covered by said claim has been in use since 1895.

As to the first ground upon which the protest is based, I do not find any provision in the rules or decisions authorizing a primary examiner to delay the issue of a patent to an applicant otherwise entitled thereto by allowing a third party, outside of the office, to establish facts by proofs not in the possession of the office. Especially is this true when it is not certain that, even if the facts relied upon were established by said third party, the patent would be refused. Rule 12, of the rules of practice, would seem to indicate that it is ordinarily against the policy of the office to allow outside parties to interfere in the prosecution of an application.

In regard to the second ground upon which the protest is based, I decided at an informal hearing given Messrs. Dyer, Edmonds and Dyer, that the affidavits filed May 1, 1899, did not make out a *prima facie* case of public use, but those affidavits, in connection with the affidavit of Mr. Edison, filed May 11, 1899, which is sent herewith, it is thought, do make out such a *prima facie* case and I therefore recommend that public-use proceedings be instituted to determine whether any device covered by Douglass' claim 1, has been in public use more than two years prior to Douglass' application.

I send herewith the Douglass application.

Respectfully submitted.

J. T. NEWTON.

51

EXHIBIT D.

Filed February 7, 1902.

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
WASHINGTON, D. C., June 10, 1899.

Messrs. Dyer, Edmonds & Dyer, No. 31 Nassau street, New York, N. Y.

SIRS: Enclosed please find a copy of the order which has been issued this day in the matter of the protest of the National Phonograph Company of Orange, New Jersey, against the issuing of a

patent to Leon F. Douglass. You are invited to be present and take part in the preliminary hearing before the Commissioner at the time specified in the enclosed order.

Very respectfully yours,

C. H. DUELL,
Commissioner.

52

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE, June 10, 1899.

Mr. Leon F. Douglass, care of Messrs. Munday, Evarts & Adcock,
Marquette block, Chicago, Illinois.

SIR: This office is in receipt of certain affidavits, copies of which are herewith enclosed, filed by Messrs. Dyer, Edmonds & Dyer, of No. 31 Nassau street, New York, N. Y., on behalf of the National Phonograph Company of Orange, New Jersey, alleging that the invention claimed by you in your application serial No. 704,508, filed February 4, 1899, for talking machines, has been in public use for more than two years prior to the filing date thereof. These affidavits have been referred to the primary examiner having the application in charge, and he has made a report to the Commissioner that in his opinion these affidavits make out a *prima facie* case that the invention described in such application has been in public use for more than two years prior to the date of your application, and he recommends that public-use proceedings be instituted to determine whether the device covered by your claim 1 has been in public use as alleged.

You are hereby requested to show cause, if any you have, before the Commissioner of Patents at eleven o'clock a. m., on Thursday, June 22, 1899, why a public-use proceeding should not be instituted.

53 Affiants have been furnished with a copy of this order, through their attorneys, Messrs. Dyer, Edmonds and Dyer, and have been invited to appear and take part in the hearing before the Commissioner at the time and date stated.

Very respectfully yours,

C. H. DUELL,
Commissioner.

54

EXHIBIT E.

Filed February 7, 1902.

JUNE 27, 1899.

United States Patent Office.

In the Matter of the Protest of the American Graphophone Company against the Issue of Patent to LEON F. DOUGLAS on Application—Serial No., 704,508—Filed February 4, 1899, for a Talking Machine.

On May 1 and May 11, 1899, certain affidavits were filed in this office, alleging that patent should not be granted to Leon F. Douglass on his application, serial No. 704,508, filed February 4, 1899, for

a talking machine, on the ground that substantially the same invention claimed by him had been in public use for more than two years prior to the date of the said application. These affidavits were referred to the primary examiner, who on June 7, 1899, reported to the Commissioner that they made out a *prima facie* case against the grant of a patent to Douglass. At the same time he called the Commissioner's attention to the fact that another application, filed by Thomas H. Macdonald, disclosed substantially the same invention as that claimed by Douglass, and that one of Macdonald's claims had been suggested to Douglass, who had incorporated it in his case, and he recommended that if public-use proceedings were instituted by the Commissioner, Macdonald should be notified.

From the showing made by the protestants at the hearing it seems to me that testimony should be taken to prove certain statements set up in the affidavits filed by them. As the Macdonald application interferes with that of Douglass, however, it is thought best not to institute proceedings at this stage, but that the interference should be declared, so that the parties can inspect each other's application and the extent of the proceeding may be more intelligently determined.

It is therefore directed that the examiner immediately declare the interference, and that after its declaration the examiner of interferences set a time within ten days from the date of this decision within which the parties shall file their preliminary statements. When such preliminary statements are opened, further proceedings will be taken on the protest against the granting of a patent.

C. H. DUELL,
Commissioner.

June 30, 1899.

56

EXHIBIT F.

Filed February 7, 1902.

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
WASHINGTON, D. C., *July* 18, 1899.

The National Phonograph Company, care of Dyer, Edmonds & Dyer, No. 31 Nassau street.

GENTLEMEN: Enclosed please find a copy of an order issued this day in the matter of your protest against the granting of a patent to Leon F. Douglass on his application filed February 4, 1899, serial No. 704,508.

You will please furnish the opposing parties and this office with the names and addresses of the witnesses and the place where you intend to examine them.

You may also send a check for fifty dollars to pay the expenses of the officer detailed to represent this office in conducting the proceedings.

Very respectfully yours,

C. H. DUELL,
Commissioner.

57

United States Patent Office.

In the Matter of the Protest of the National Phonograph Company against the Issue of Patent to LEON F. DOUGLAS on Application—Serial No., 704,508—Filed February 4, 1899, for a Talking Machine.

In accordance with the Commissioner's decision of June 30, 1899, the applications of Douglass and Macdonald have been placed in interference. Each party has filed a preliminary statement, as required in said decision, and the application of each is now open to inspection by the other.

It is ordered that the taking of testimony to show whether or not the device covered by the subject-matter of the issue or the devices set up in the affidavits and exhibits of the protestant have been in use as alleged, begin on Monday, August 14, 1899, and continue from day to day until concluded.

The American Graphophone Company having filed an assignment from Macdonald to it, covering said application, this company may be made a party to these proceedings, as requested in their petition of June 20, 1899, and in accordance with the decision of the Commissioner of June 30, 1899.

The taking of the testimony will be governed, as far as practicable, by the rules of this office relating to the taking of testimony in interferences and other contested cases.

W. A. Megrath, law clerk, is detailed to represent this office and to conduct the proceedings.

C. H. DUELL,
Commissioner.

July 18, 1899.

58

EXHIBIT G.

Filed February 7, 1902.

In the United States Patent Office.

In the Matter of the Public-use Proceedings against the Application of LEON F. DOUGLASS.

To the honorable Commissioner of Patents :

Having been informed that the interference of Douglass *v.* Macdonald has been finally decided in favor of Macdonald, and that the public-use proceedings directed against the application of Douglass therefore present only a moot question, we move your honor, on behalf of the protestant National Phonograph Company, to reform said public-use proceedings by including the said Macdonald application therein ; and further, that the protestant may be allowed, through its attorneys, to examine the said Macdonald application and the said interference proceedings, and be furnished by the Patent Office copies of such portions thereof as it may desire.

In support of this motion we will refer to the records of the Patent Office relating to the public-use proceedings already instituted.

DYER, EDMONDS & DYER,
Attorneys for National Phonograph Co.

59

EXHIBIT H.

Filed February 7, 1902.

United States Patent Office.

In the Matter of the Protest of the National Phonograph Company against the Issue of a Patent to Douglass and the Request that Macdonald be Included in the Proceedings.

In view of the questions that are now raised in this proceeding it is deemed advisable to state again certain actions that have heretofore been taken in the case.

In May, 1899, affidavits were filed in this office on behalf of the National Phonograph Company, alleging that substantially the invention claimed by Leon F. Douglass in his application serial No. 704,508, filed February 4, 1899, had been in public use for more than two years prior to the date of the said application. These affidavits were as usual referred to the primary examiner for consideration, who, on June 7, 1899, informed the Commissioner that a *prima facie* case was made out against the grant of a patent to Douglass.

On the same date the examiner called the Commissioner's attention to the fact that there was pending in the office an application of Thomas H. Macdonald "which disclosed and claimed substantially the same invention as is claimed by Douglass. Indeed, one of Macdonald's claims has been suggested to Douglass and Douglass has incorporated it in his case * * * . I therefore * * *

60 recommend that Macdonald be notified of the public-use proceedings, if you decide that such proceedings should be instituted."

I then considered the recommendation of the examiner and directed that public-use proceedings be instituted. I also made an order that as the Macdonald application interfered with that of Douglass, the interference should be declared so that the parties could inspect each other's applications and the extent of the public-use proceeding might be intelligently determined.

Prior to the declaration of the interference, however, the American Graphophone Company, who claimed to be the assignee of the Macdonald application, petitioned that it be admitted as a party in interest to defend the public-use proceedings. This request was granted after the proper assignment had been placed on record.

After the interference was declared and the preliminary statements were opened, the Commissioner, on July 18, 1899, ordered that the public-use proceedings be instituted and time was set for taking the testimony. Before this time arrived, however, the Na-

tional Phonograph Company made a motion to extend the time for taking this testimony, and on August 18, 1899, the acting Commissioner granted the motion.

On September 14, 1899, the protestant filed a motion in the office requesting that the application of Macdonald be included in the public-use proceedings, so that any order made in such proceedings would run against the Macdonald case. On October 9, 1899, I decided that it was not necessary that the protestant be furnished with a copy of the Macdonald application, although Macdonald was in one sense a party to the public-use proceeding-; that as it had filed affidavits alleging that a certain machine or machines had been in public use at a certain time, it was incumbent upon it to prove its

61 allegations by proper evidence; that when this evidence was before the office the office would be competent to judge whether the evidence was sufficient to prevent the grant of a patent to Douglass, and that as Macdonald's assignee had been made a party to the proceedings at its own request and had a right to cross-examine the witnesses produced on behalf of protestant, the evidence would be used against Macdonald in the consideration of his application on the question of patentability.

Since this decision no definite time has been set within which to take testimony in the public-use proceedings, because on oral requests that proceedings have been continued. But Macdonald made a motion that the proceedings in the interference case be resumed. This request was granted and it was deemed advisable to suspend the public-use proceedings until after the termination of the interference proceedings.

On November 1, 1900, the Assistant Commissioner rendered a decision awarding priority to Macdonald, and this decision has become final. Macdonald then made a motion in the public-use proceedings that his application be passed to issue, because he was entitled to the grant of a patent, as no legal obstacle existed against the grant, and that since no public-use proceedings had been instituted against him or his application included in the proceedings there was no evidence to show that he was not entitled to a patent.

Subsequently to this, on January 30, 1901, the protestant filed a paper stating that as the interference had been decided in favor of Macdonald the public-use proceedings directed against Douglass presented only a moot question, and the protestant requested
62 that the public-use proceedings be reformed by including the application of Macdonald, and that it be allowed through its attorneys to examine the Macdonald application and the interference proceedings and be furnished with copies of such portions as it desired.

I have already decided that it was not necessary that the protestant be furnished with a copy of the Macdonald application, and I see no reason to change my opinion on this subject. The protestant has alleged in its affidavits that a machine had been made and put in public use at a certain time. The examiner has called the Commissioner's attention to the fact that the Macdonald application dis-

closes and claims substantially the same invention as that claimed by Donglass. This being so, it is only necessary for the protestant to prove what it has set up in its affidavits, and I do not think it is necessary for this proceeding that it should be furnished with a copy of the Macdonald application, and must therefore decline to grant the request.

I cannot agree with Macdonald, however, that his application should be passed to issue merely because it was not included in the public-use proceedings. Macdonald's assignee requested, during the early public-use proceedings against Douglass, that it be made a party to the proceedings and that it might be present and examine the witnesses produced on behalf of the protestant, which request was granted, and it was held that the evidence adduced might be used against the Macdonald application on the question of patent-

63 ability. When the attention of the Commissioner has been called to a *prima facie* case of public use, as has been done here, I think it is the duty of the Commissioner under the statutes to inquire into the matter and not issue a patent on any application which would be affected by the evidence properly adduced on the subject.

In this case I deem it the duty of the Commissioner to continue the public-use proceedings and to give Macdonald an opportunity to appear and cross-examine the witnesses who are to be examined and to hold his application subject to the testimony taken. Although this proceeding has been delayed until after the final determination of the interference case, yet this delay was to a certain extent at the request of Macdonald, and it was never intended that if he were successful in the interference proceeding his application should be passed to issue without the taking of testimony in the public-use case.

In view of the delay which has occurred it is directed that the testimony be promptly taken.

It is therefore ordered that the taking of the testimony begin on Monday, February 18, 1901, and continue from day to day until concluded. The protestant will furnish Macdonald and this office with the names of the witnesses to be examined and the place where the testimony is to be taken.

In the further proceedings in this case the name of Macdonald will be substituted for that of Douglass in the title.

William A. Megrath, law clerk, is detailed to represent the office and conduct the proceedings.

C. H. DUELL,
Commissioner.

February 11, 1901.

64

EXHIBIT I.

Filed February 7, 1902.

In the United States Patent Office.

NATIONAL PHONOGRAPH COMPANY, Pro-	}	Public-use Proceedings.
testant,		
vs.		
THOMAS D. MACDONALD, Respondent.		

To the honorable Commissioner of Patents in person :

And now comes the protestant, National Phonograph Company, and moves the honorable Commissioner of Patents to transmit the Macdonald file and the other papers herein to the examiner of interferences with the direction to proceed with the case in accordance with the rules in interference cases and under the practice established in the Alteneck case.

NATIONAL PHONOGRAPH COMPANY,
By DYER, EDMONDS & DYER, *Attorneys*.

New York, January 2, 1902.

65

EXHIBIT J.

Filed February 7, 1902.

JUNE 10, 1902.

United States Patent Office.

Ex Parte THOMAS H. MACDONALD.

Recording and reproducing sounds.

Public-use proceedings.

Mr. Philip Mauro for applicant.

Messrs. Dyer, Edmonds and Dyer for protestant.

This case comes up on a petition by the applicant that his application be at once passed to issue.

It appears that on June 7, 1899, the primary examiner reported that a protest and affidavits filed by the National Phonograph Company made out a *prima facie* case of public use of an invention in phonographs claimed in an application of one Leon F. Douglass for more than two years before that application was filed. While the question of instituting an investigation of the question of public use in that case was under consideration, the American Graphophone Company filed a request that it be allowed to take part in the proceedings. This request was granted upon the admission of the American Graphophone Company that it is the assignee of an application filed by Macdonald for the same invention and against which

application the bar of two years' public use if established might be used.

66 On June 30, 1899, Commissioner Duell decided that the public-use proceedings should be instituted, but that an interference should first be declared between the Douglas and Macdonald applications. This interference was declared. On July 18, 1899, it was ordered that testimony on the question of public use begin on August 14, 1899. The taking of testimony was, however, postponed and the interference was proceeded with. The public-use proceedings were suspended by the office during the interference. On November 1, 1899, the Assistant Commissioner rendered a decision on priority and that decision became final. Thereafter, Macdonald asked that his application be passed to issue without regard to the public-use proceedings. This request was denied by Commissioner Duell and on February 11, 1901, he issued an order that testimony be taken to determine whether the invention had been in public use for more than two years before the date of Macdonald's application.

The National Phonograph Company took an appeal to the Secretary of the Interior from certain parts of this order, and it seems to have been considered that such appeal operated as a stay, for no testimony was taken in accordance with the order. The appeal was disposed of by the Secretary of the Interior on December 5, 1901, and Macdonald thereupon filed his present petition that his application be passed to issue.

There has undoubtedly been much delay in determining the question of public use, and, as pointed out by Macdonald, such delay is prejudicial to his interests, since others, including the pro-
67 testant in this case, are making and selling the invention upon which he hopes to secure a patent. If Macdonald's application is to be further suspended to investigate the question of public use, the taking of testimony must proceed with the utmost dispatch and the proceedings must close at the earliest date possible. While the delay which has occurred is much to be regretted, it is the duty of the Commissioner under the law to investigate the question of public use of an invention, if he has reason to believe that it occurred more than two years before the application was filed, and that proper evidence to that effect can be obtained. The statutes make such use a bar to the grant of a patent and specifically authorize an investigation of the matter by the Commissioner, and therefore it is believed that the Commissioner would not be justified in allowing a patent without such investigation.

The National Phonograph Company has filed a motion that this case be referred to the examiner of interferences with instructions to institute public-use proceedings as a contest between the National Phonograph Company and Macdonald and set times for taking testimony as in interferences. In this motion it is believed that the National Phonograph Company has misunderstood the nature of the proceedings. Proceedings of this kind should be looked upon solely as an investigation by the Commissioner of Patents and not

as a contest between two parties. The Commissioner on behalf of the public takes testimony when he considers it necessary in order to satisfy himself whether or not there is a bar of two years' public use and the proceedings are not instituted in any case because of the supposed interest of the party who protest- against the issue of a patent

and furnishes the information as to the alleged use. No person
68 can be considered to have such an interest as to demand in his own right that the issue of a patent be suspended and an investigation instituted unless he is himself an applicant for a patent for the same thing. The protestant may in fact have such an interest as will induce him to be willing to produce the witnesses in support of the alleged bar of public use and to bear the expense incident to investigating the question, and this office may avail itself of his assistance in the matter for the reason that it could not discover and establish the facts in any other way, but this does not make the proceedings a contest between the protestant and the applicant. It is merely an investigation by the Commissioner and it will be conducted as such.

The petition that Macdonald's application be at once passed to issue is denied.

It is ordered that the taking of testimony in support of the allegation of public use begin on Monday, February 3, 1902, or if the witnesses cannot be produced at that time, upon some day during the week then commencing to be fixed by the protestant, and that it shall be completed with the utmost diligence. The National Phonograph Company will at once notify this office and Macdonald of the names of the witnesses and the place where they will be produced for examination during the week stated. Upon its failure to do so, it will be assumed that it is no longer willing to assist this office in the investigation, and the action upon Macdonald's application will be governed accordingly.

John M. Coit, law clerk, is detailed to represent the office and conduct the proceedings.

F. I. ALLEN,
Commissioner.

January 24, 1902.

69

Affidavit of Richard N. Dyer.

"EXHIBIT K."

Filed February 7, 1902.

In the Supreme Court of the District of Columbia.

THE UNITED STATES OF AMERICA on the
 Relation of National Phonograph Company,
 Relator,

vs.

FREDERICK I. ALLEN, Commissioner of Pat-
 ents, Respondent.

At Law. No. 45225.

Richard N. Dyer, having been duly sworn, makes oath and says:

I am the patent counsel of the National Phonograph Company, relator to the foregoing petition, and as such I have had charge for the National Phonograph Company of the public-use proceedings mentioned in said petition. I am informed by my brother, Leonard H. Dyer, who was my representative in the city of Washington in connection with the said public-use proceeding, that a copy of the order dated January 24th, 1902, filed as Exhibit J to the said petition, was sent to him by mail, and was not received until the said 27th day of January, 1902, which was Monday. Thereupon the said Leonard H. Dyer at once communicated with me, who was then in the city of New York. In consequence of illness I was unable to take immediate action with respect to the matter of the said order, but on Friday, the 31st day of January, at my instance, the said Leonard H. Dyer notified the said John M. Coit, referred to in the said order, of my illness, and that I would call at the office of the said

70 Commissioner on the following Monday, February 3rd, when

I would inform him as to what action I proposed to take in the premises. On Monday, the said 3rd day of February, I accordingly called at the office of the said Commissioner of Patents, and informed him that I had consulted local counsel with respect to the rightful status of the National Phonograph Company in the pending public-use proceeding, and that the said company had retained counsel for the purpose of applying to the supreme court of the District of Columbia for a writ of mandamus to compel him, the said Commissioner, to recognize the right of the said company as an active participant in the said public-use proceedings, upon the analogy of an interference proceeding, in accordance with the long-standing practice of the said office hereinbefore set forth in the said petition for a mandamus. I then and there further informed the said Commissioner that a petition for the said writ was in course of preparation, and would certainly be filed within the week beginning February 3rd; further, that according to my understanding of the

said order of January 24th, the said company had the whole of the said week beginning February 3rd wherein to take action, and that I would take it for granted that if application for a mandamus were made within the said week, it would be in time to anticipate any further action of the Patent Office in the public-use proceeding. To this the Commissioner apparently assented, and remarked to me that "he considered the question to be raised by the mandamus proceedings a very interesting one, and one which he would like to see finally settled." My brother, Leonard H. Dyer,

71 was present during the whole of this interview with the said Commissioner, and heard all that passed between us.

Thereupon my brother and I left the office of the said Commissioner, and had no further communication with him. The petition for mandamus was then accordingly prepared, and was taken to Orange, New Jersey, on Tuesday, the 4th of February instant, for the purpose of having the same verified by the aforesaid National Phonograph Company, which has its principal office at the said place.

Further, I say that nothing further in the premises was heard either from the said Commissioner or from John M. Coit, mentioned in the said order of January 24th, until Thursday, the 6th day of February instant, when the said Leonard H. Dyer received through the mail from the said Commissioner of Patents what purported to be a copy of an order issued by the said Commissioner, and which is attached to the aforesaid original petition as Exhibit L.

RICHARD N. DYER.

Subscribed and sworn to before me this 7th day of February, A. D. 1902.

J. R. YOUNG, *Clerk*,

By L. P. WILLIAMS, *Ass't Clerk*.

72

Affidavit of Leonard H. Dyer.

Filed February 7, 1902.

In the Supreme Court of the District of Columbia.

THE UNITED STATES OF AMERICA on the
Relation of National Phonograph Com-
pany, Relator,

vs.

FREDERICK I. ALLEN, Commissioner of Pat-
ents, Respondent.

At Law. No. 45225.

Leonard H. Dyer, having been duly sworn, makes oath and says:

I am a patent attorney, practicing before the United States Patent Office, and residing in the District of Columbia. I have been acting as the representative of my brother Richard N. Dyer, who is the patent counsel for the National Phonograph Company, which is the

relator in the petition to which this affidavit is annexed. On the 27th day of January, 1902, I received by mail from the Commissioner of Patents what purported to be a copy of an order or decision of the said Commissioner, under date of January 24th, 1902, a copy of which is Exhibit J to the said petition. Thereupon I at once communicated with my brother, Richard N. Dyer, who was then in the city of New York. I am informed by my brother that in consequence of illness he was unable to take immediate action with respect to the matter of the said order; but on Friday, the 31st day of January, at his instance, I notified the said John M. Coit, referred to in the said order, of my brother's illness, and that he would

73 call at the office of the said Commissioner on the following Monday, February 3rd, when he would inform him, the said Commissioner, as to what action he prop-osed to take in the premises. On Monday, the said 3rd day of February, my brother, Richard N. Dyer, accordingly called at the office of the said Commissioner of Patents, and informed him that he had consulted local counsel with respect to the rightful status of the National Phonograph Company in the pending public-use proceeding, and that the said company had retained counsel for the purpose of applying to the supreme court of the District of Columbia for a writ of mandamus to compel him, the said Commissioner, to recognize the right of the said company as an active participant in the said public-use proceeding, upon the analogy of an interference proceeding, in accordance with the long-standing practice of the said office set forth in the said petition for a mandamus. He then and there further informed the said Commissioner that a petition for the said writ was in course of preparation, and would certainly be filed within the week beginning February 3d; further, that according to his understanding of the said order of January 24th, the said company had the whole of the said week beginning February 3rd wherein to take action, and that he would take it for granted that if application for a mandamus were made within the said week it would be in time to anticipate any further action of the Patent Office in the public-use proceeding. To this the Commissioner apparently assented, and remarked to my brother that "he considered the question to be raised by the mandamus proceedings a very interesting one, and one which he would like to see finally settled."

74 I was present during the whole of this interview with the said Commissioner, and heard all that passed between him and my said brother.

Thereupon my brother and I left the office of the said Commissioner, and had no further communication with him. The petition for mandamus was then accordingly prepared, and was taken to Orange, New Jersey, on Tuesday, the 4th of February instant, for the purpose of having the same verified by the aforesaid National Phonograph Company, which has its principal office at the said place.

Further, I say that nothing further in the premises was heard either from the said Commissioner or from John M. Coit, mentioned

in the said order of January 24th, until Thursday, the 6th day of February instant, when I received through the mail from the said Commissioner of Patents what purported to be a copy of an order issued by the said Commissioner, and which is attached to the afore-said original petition as Exhibit L.

LEONARD H. DYER.

Subscribed and sworn to before me this 7th day of February, A. D. 1902.

J. R. YOUNG, *Clerk*,
By L. P. WILLIAMS, *Ass't Clerk*.

75

EXHIBIT L.

Filed Feb. 7, 1902.

United States Patent Office.

Ex Parte THOMAS H. MACDONALD.

Recording and reproducing sounds.

Public-use proceedings.

Mr. Phillip Mauro for applicant.

Messrs. Dyer, Edmonds and Dyer, for protestant.

On January 24, 1902, an order was issued that the taking of testimony in support of the allegation of public use in this case begin on Monday, February 3, or at some time during the week then commencing, and that:

"The National Phonograph Company will at once notify this office and Macdonald of the names of the witnesses and the place where they will be produced for examination during the week stated. Upon its failure to do so, it will be assumed that it is no longer willing to assist this office in the investigation, and the action upon Macdonald's application will be governed accordingly."

The National Phonograph Company has not complied with this order, and, since it is apparently not willing to produce the witnesses to the alleged public use for examination, a continuance of the investigation is impractical.

76 The order instituting the public-use proceedings is set aside and Macdonald's application is remanded to the primary examiner for consideration and action.

F. I. ALLEN,
Commissioner.

February 5, 1902.

Memorandum.

Return to rule to show cause filed March 25, 1902, stricken out as insufficient and respondent allowed 10 days in which to file answer.

77

Return of Respondent to Rule to Show Cause.

Filed April 9, 1902.

In the Supreme Court of the District of Columbia.

THE UNITED STATES OF AMERICA on the Relation of the National Phonograph Com- pany, a Body Corporate, Relator,	} At Law. No. 45225.
vs.	
FREDERICK I. ALLEN, Commissioner of Pat- ents, Respondent.	

Return of respondent to rule to show cause why a writ of mandamus should not issue.

The said Frederick I. Allen, Commissioner of Patents, comes and as his answer to the order to show cause why the said writ of mandamus should not issue says:

The respondent admits that he is the Commissioner of Patents duly qualified and acting as such, and that he was such Commissioner and acting as such on January 24, 1902, and has continued to so act since that date, as alleged in the first paragraph of the petition.

The respondent admits the allegations of the 5th, 6th, 7th, and 8th paragraphs of the petition.

The respondent admits that the relator complied with the order of July 18, 1899, mentioned in the 9th paragraph of the petition, in so far as notice of the names of the witnesses and place of examination and furnishing \$50.00 are concerned, but alleges that it
78 made a motion to extend the times for taking testimony, which motion was granted. The times were subsequently extended by the acting Commissioner upon his own motion, and the taking of testimony was finally suspended until the interference between Douglass and Macdonald was concluded.

The respondent alleges that the relator made application to the Patent Office for a copy of Macdonald's application and in a decision rendered October 9, 1899, the then Commissioner of Patents decided that it was not entitled to see and obtain copies of Macdonald's application, a copy of which decision is hereto attached as Exhibit A.

That the relator filed a petition to the Secretary of the Interior from this ruling, and the Secretary dismissed the petition on the ground of lack of jurisdiction because the question had been judicially determined by the Commissioner, a copy of which decision is hereto attached as Exhibit B.

That on November 1, 1900, a decision was rendered in the interference in favor of Macdonald as the first inventor.

The respondent admits the allegations of the 10th paragraph of the petition.

The respondent admits the allegations of the 11th paragraph of
6—1257A

the petition and annexes hereto and as a part hereof a copy of the said decision of the Secretary of the Interior as Exhibit C.

The respondent admits the allegations of the 12th paragraph of the petition. In regard to this matter, the respondent alleges further that in said decision of January 24, 1902, the relator was specifically informed that it was not a party in interest and was not entitled to contest the issue of a patent to Macdonald, and it was ordered
79 that the taking of testimony begin during the week commencing February 3, 1902, and it was said :

"The National Phonograph Company will at once notify this office and Macdonald of the names of the witnesses and the place where they will be produced for examination during the week stated. Upon its failure to do so, it will be assumed that it is no longer willing to assist this office in the investigation, and the action upon Macdonald's application will be governed accordingly."

That the relator did not at once notify the respondent of the names of the witnesses and the place where they would be produced for examination during the time stated, as required ; but, on the contrary, counsel notified him orally on or about Monday, February 3, that the witnesses would not be produced during the week commencing February 3, 1902, and that the relator intended to apply to the courts for a mandamus compelling the respondent to conduct the investigation as a contest.

That upon consideration of all of the facts the respondent decided that an investigation of the relator's allegations of public use was not warranted, and therefore notified the relator and Macdonald on February 5, 1902, that the order instituting the investigation was set aside and Macdonald's case was remanded to the primary examiner for consideration and action, as will appear from the decision then rendered, a copy of which is attached to the petition as Exhibit L. .

This respondent denies that his personal office is "organized as a court having appellate jurisdiction only," as alleged in the 13th paragraph of the petition.

80 The respondent alleges that he is the head of the Patent Office, with power to act personally in any case coming before it.

The respondent further admits that the relator has no remedy by appeal or writ of error. The respondent alleges that no appeal lies to the Secretary of the Interior, because the question is one judicially determined by the respondent as an executive officer of the Government.

He further alleges that an appeal would lie if he had failed to perform some ministerial duty prescribed by rules approved by the Secretary of the Interior.

The respondent admits that the supreme court of the District of Columbia rendered a decision in the case of Von Hefner Alteneck, (23 O. G., 269) in regard to the rejection of applications on the ground of two years' public use, and that on an appeal to the Secretary of the Interior from a ruling of the Commissioner of Patents

(23 O. G., 2233,) in that case the Secretary rendered a decision, (23 O. G., 2233), affirming the action of the Commissioner, but denies that said decisions established a rule of practice providing for a contested proceeding which was to be conducted in accordance with the rules in interference cases.

The respondent further alleged that the practice in the Patent Office is governed by the laws passed by Congress and a set of rules made by the Commissioner of Patents and approved by the Secretary of the Interior in accordance with section 483 of the Revised Statutes, and published in pamphlet form, entitled Rules of Practice in the United States Patent Office, under the authority of section 488 of the Revised Statutes.

81 That the last edition of said rules of practice approved by the Secretary of the Interior on July 18, 1899, contains the following as rule 213:

"213. All cases not specifically defined and provided for in these rules will be decided in accordance with the merits of each case under the authority of the Commissioner, and such decision will be communicated to the interested party in writing."

That these rules of practice do not specifically prescribe the procedure in public-use investigations.

The respondent further shows to the court that he has judicially determined that an investigation of the question of public use in this case is not warranted. And the respondent insists on this special matter of defense and asks to have the same benefit therefrom as if he had demurred specially to said petition.

The respondent further answering says, that the petition of the relator does not allege as a matter of fact that it is entitled to a patent upon the invention claimed by Macdonald. And the respondent insists on this special matter of defense and asks to have the same benefit therefrom as if he had demurred specially to said petition.

The respondent further says that by reason of the facts hereinbefore alleged, he should be dismissed with his reasonable costs.

FREDERICK I. ALLEN.

JOHN M. COIT, *Counsel*.

82 DISTRICT OF COLUMBIA, ss :

On this day personally appeared before me a notary public in and for the said District of Columbia, Frederick I. Allen, and made oath that he is the respondent in the above-entitled cause; that he has read the foregoing answer by him subscribed and knows the contents thereof; that the same is true of his own knowledge except the matters therein stated on his information and belief, and that as to these matters he believes it to be true.

Given under my hand this 9th day of April, 1902.

[SEAL.]

A. M. BUNN,

Notary Public for District of Columbia.

Filed April 9, 1902.

SEPT. 15, 1899.

United States Patent Office.

In the Matter of the Protest of the National Phonograph Company
against the Issue of a Patent to Leon F. Douglass.

In May, 1899, certain affidavits were filed in this office alleging that patent should not be granted to Leon F. Douglass on an application, serial No. 704,508, for a talking machine, on the ground that substantially the same invention claimed by him had been in public use for more than two years prior to the date of the said application. In considering these affidavits the examiner reported that a *prima facie* case against the grant of the patent had been made out, and he also called the Commissioner's attention to the fact that another application filed by Thomas H. Macdonald discloses substantially the same invention as that claimed by Douglass.

At the preliminary hearing of the public-use question the American Graphophone Company, who claimed that it was the assignee of the Macdonald application, petitioned that it be admitted as a party in interest to defend the public-use proceedings, as it had obtained certain evidence which led it to believe that Douglass would not properly defend the proceedings, and unless the said company was made a party the controversy would not be conducted in such a manner as to insure a just conclusion.

84 On June 30, 1899, I made an order in the case that the Macdonald and Douglass applications be put in interference before the institution of the public-use proceedings, so that the parties could inspect each other's cases and the scope of the proceedings be more intelligently determined. At the same time I made an order granting the petition of the graphophone company, provided it would file in this office the assignment to it from Macdonald, which was subsequently done.

On July 18, 1899, the order was issued instituting the public-use proceedings, and Monday, August 14, 1899, was set as the time to begin the taking of testimony. On August 8, 1899, the protestants in this case made a motion to extend the time for taking testimony, and also that they be permitted to have copies of the files of the applications of Macdonald and Douglass. On August 11, 1899, the acting Commissioner granted the motion to extend the time for taking testimony, but did not pass upon the right of the contestants to obtain copies of the applications. It seems that at the hearing before him, however, it was understood that the protestants would not urge this request.

On September 1, 1899, the attorneys for Macdonald and the American Graphophone Company filed a paper in this office in which they stated that they had been informed by one of the attorneys for

the protestants that his firm had been furnished by this office with a copy of the file-wrapper and contents of the Macdonald application and they requested information as to why this copy had been furnished. On September 6th he was informed that on the 10th of August the attorneys had filed an order for a copy of said application, and this order was filled by the office under the misapprehension that a request had been made for such copy which request had been granted.

85 On September 14, 1899, the protestants filed a formal motion in this office requesting that the application of Macdonald be included in the public-use proceedings, so that any order in the proceedings may run against the application of Macdonald as well as against that of Douglass.

On September 15, 1899, the attorney for Macdonald and his assignee made a motion that an order be issued directing the attorneys for the protestants to return the copy of the application obtained by them, and that no information be given to them concerning the application of Macdonald.

At the hearing before me on these motions the copy of the Macdonald application which had been obtained by the protestants was presented and was turned over to the office awaiting the determination of the question as to whether they were entitled to obtain it.

Without passing upon the question as to the authority of the Commissioner of Patents to furnish parties with copies of applications when requested, it is enough to say here that I do not think it is necessary for the proper conduct of these public-use proceedings that the protestants should have a copy of the Macdonald application. They have filed affidavits alleging that a certain machine or machines have been made and were in public use at a certain time. It is incumbent upon them to prove their allegations by proper evidence. When this evidence is before the office, the office is competent to judge whether the machine was in public use at the time alleged, and whether the evidence is sufficient to prevent the

86 grant of a patent to Douglass. Of course as Macdonald's assignee has been made a party to these proceedings at its request and has the right to cross-examine the witnesses produced on behalf of the protestants, this evidence will be used against Macdonald in the consideration of his application on the question of patentability.

The fee paid by the protestants for the copy of the Macdonald application will be returned upon request.

C. H. DUELL,
Commissioner.

October 9, 1899.

87

EXHIBIT B.

Filed April 9, 1902.

DEPARTMENT OF THE INTERIOR,
WASHINGTON, *January 26, 1900.*

The Commissioner of Patents.

SIR: The petition of the National Phonograph Company by Leonard Huntress Dyer, its attorney, for review of your adverse action of November 1, 1899, in the matter of the public-use proceedings in the case of Leon F. Douglass, applicant for patent, serial No. 704,508, filed February 4, 1899, for talking machines, is dismissed for the reason that the question involved therein is one which has been judicially determined by the Commissioner of Patents, and in such cases, the Secretary of the Interior has no appellate jurisdiction, (U. S. *ex rel. Hoe v. Butterworth*, 112 U.S., 50; Op. Ass't — Gen'l Interior Department dated February 20, 1899, in *Poole v. Avery*).

Mr. Dyer, the attorney for the National Phonograph Company has been informed as to the disposition of the case.

Very respectfully, E. A. HITCHCOCK, *Secretary.*

88

EXHIBIT C.

Filed April 9, 1902.

DEPARTMENT OF THE INTERIOR,
WASHINGTON, *December 5, 1901.*

The Commissioner of Patents.

SIR: I have considered the petition filed by L. H. Dyer, in behalf of the National Phonograph Company for a review of your decision of February 11, 1901, entitled *Ex parte* Thomas H. Macdonald in the matter of a protest of the National Phonograph Company against the issue of a patent to Douglass and the request that Macdonald be included in the proceedings.

The petition in effect prays for a reversal of said decision of February 11, 1901, "in so far as it denies the right of your petitioner to examine the said Macdonald application and the interference proceedings between said Macdonald and said Douglass and to be furnished with copies of such portions thereof as it may desire" etc.

Substantially the same question was presented to this department by the petitioners for a review of the adverse action of the Commissioner of Patents November 1, 1899 in the matter of the public-use proceedings in the case of Leon F. Douglass, applicant for patent serial number 704,508 filed February 4, 1899 for talking machines.

89 Upon consideration of such petition, it was dismissed under date of January 26, 1900 for the reason that the question involved therein was one which had been judicially determined by the Commissioner of Patents and in such cases the Secretary of the Interior has no appellate jurisdiction. (U. S. *ex rel. Hoe vs. Butter-*

worth, 112 U. S. 50; Op. Ass't Att'y Gen'l • Interior Department dated February 20, 1899 in *Poole v. Avery.*) The petition under consideration is accordingly dismissed for similar reasons.

In this connection, it is proper to add that an examination of the papers submitted by your office in connection with the petition and briefs of counsel indicates that the rules of practice of the Patent Office are defective, in that the method of procedure in the "public-use proceedings" is not prescribed. It is suggested therefore, that a rule of practice to govern public-use proceedings be formulated and submitted to the department for its consideration at an early day.

The papers belonging to the files of your office are herewith returned.

Mr. Philip Mauro representing the American Graphophone Company assignee of Thomas H. Macdonald and Mr. Leonard H. Dyer representing the National Phonograph Company, have been advised as to the disposition of the case.

Very respectfully,

E. A. HITCHCOCK, *Secretary.*

90

Exceptions to Amended Return.

Filed April 12, 1902.

In the Supreme Court of the District of Columbia.

THE UNITED STATES OF AMERICA on the Re-	} At Law. No. 45225.
lation of the National Phonograph Com-	
pany, a Body Corporate, Relator,	
vs.	
FREDERICK I. ALLEN, Commissioner of Pat-	}
ents, Respondent.	

Now comes the petitioner in the above-entitled cause through Messrs. Frank Dyer and Leonard H. Dyer, and R. Ross Perry & Son, attorneys for the relator, and excepts to the said amended return as insufficient in the following respects:

1. Because the said amended return does not admit or deny the allegations of fact contained in the first paragraph of the petition, save to the extent of admitting that the respondent is Commissioner of Patents as alleged, thus leaving unanswered the remaining averments of facts in the said paragraph contained which are, as said petitioner is advised, material.

2. Because the said amended return does not admit or deny the allegations of fact contained in the second paragraph of the said petition.

3. Because the said amended return does not admit or deny the allegations of fact contained in the third paragraph of the said petition.

4. Because the said amended return does not specifically
91 and in sufficient detail deny the averments of fact contained in the fourth paragraph of the said petition.

5. Because the said respondent does not admit or deny the allegations contained in the thirteenth paragraph of the said petition, save to the extent of denying that his present office is organized as a court having appellate jurisdiction, thus leaving unanswered the remaining averments in the said paragraph contained, which your petitioner is advised are material.

6. Because the averments to the matters of fact contained in the twelfth paragraph of the said petition are not as specific as is necessary to raise a certain issue thereupon.

7. Because the said amended return does not contain any answer to the matters of fact contained in the fifteenth paragraph of the said petition.

8. Because the said amended return does not contain any answer to the matters of fact contained in the sixteenth paragraph of the said petition.

9. Because the said amended return does not obey the rules of court in matter of form, in that it is not divided into paragraphs in the same manner as the petition and each paragraph does not correspond, with the paragraph of the bill of the same number, thus rendering it inconvenient for the court and for counsel to ascertain exactly what are the matters of fact averred by the petitioner and denied by the respondent.

FRANK DYER,
LEONARD H. DYER,
By R. R. P.
R. ROSS PERRY AND SON,
Attorneys for Petitioner.

92

Replication.

Filed April 21, 1902.

In the Supreme Court of the District of Columbia.

THE UNITED STATES OF AMERICA on the Relation of the National Phonograph Co., a Body Corporate, Relator, <i>vs.</i> FREDERICK I. ALLEN, Commissioner of Patents, Re- spondent.	}	At Law. No. 45225.
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Now comes the relator in the above-entitled cause, by its attorneys of record, and for plea to so much of the return of the respondent to the rule to show cause why a writ of mandamus should not issue against him as purports to be a response to the 12th paragraph of the aforesaid petition, says that the said respondent ought not to be admitted or received to plead that he, the said respondent, decided that an investigation of the relator's allegations of public use was not warranted and that the order instituting said investigation for public use was set aside and that what is designated in the return of the said respondent as the McDonald case was remanded to the

primary examiner for consideration and action, because it saith that as soon as it was brought to the notice of the said relator that the said respondent had passed the following order, to wit:

“The National Phonograph Company will at once notify this office and McDonald of the names of the witnesses and the places where they will be produced for examination during the
93 week stated. Upon its failure to do so, it will be assumed that it is no longer willing to assist this office in the investigation and action upon the McDonald application will be governed accordingly.”

an agreement was made between the said respondent and Richard N. Dyer and Leonard H. Dyer, who were then attorneys of the relator, that no further action should be taken in the said public-use proceedings until the relator should have filed its petition in the supreme court of the District of Columbia for a mandamus to said respondent to compel him as Commissioner of Patents to grant to your relator the rights of a party in interest in the said public-use proceeding and to conduct the said proceedings as a contested case under the practice prevailing in the United States Patent Office and in accordance with a decision of the supreme court of the District of Columbia in what is known as the Alteneck case and further until the decision of the said court upon the said petition should have been made. Further the relator says that acting upon said agreement its said attorneys did not notify the said office and the said McDonald as in the said order required as they should have done had they not relied upon the aforesaid agreement with the said respondent, and further it says that in reliance upon the said agreement, they did prepare and file in the supreme court of the District of Columbia, the said petition for mandamus which is the pending proceedings and that the aforesaid order of the said respondent setting aside the order instituting the public-use proceedings and remanding the said McDonald case to the primary examiner for consideration and action was in direct violation
94 of the aforesaid agreement, and this the said relator is ready to verify. Wherefore it prays judgment if the said respondent ought to be admitted or received to his said plea contrary to his own knowledge and agreement as aforesaid.

2. And for a plea to so much of the said return as denies that the personal office of the said respondent, Commissioner of Patents, is organized as a court having appellate jurisdiction only, the relator re-avers that the said office is organized as a court having appellate jurisdiction only, and this the relator is ready to verify.

3. And for a plea to so much of the said return as alleges that the said respondent is the head of the Patent Office with power to act personally in any case coming before it, the relator says that the said respondent is not the head of the Patent Office with power to act personally in any case coming before it, the said office, and this it is ready to verify.

4. And for a plea to so much of the said return as avers that an

appeal would lie to the Secretary of the Interior if the respondent Commissioner of Patents had failed to perform some ministerial duty prescribed by the rules approved by the Secretary of the Interior, the relator says that the Secretary of the Interior has judicially determined, in so far as any decision of his can be termed a judicial decision, that the duty discharged by the said respondent in determining questions arising in public-use proceedings is a judicial and not a ministerial duty, wherefore the said relator, while not

admitting the correctness of the said decision of the Secretary
95 of the Interior was yet concluded thereby in so far as any appeal from the said respondent Commissioner of Patents to the said Secretary of the Interior was concerned with respect to the aforesaid order dismissing the public-use proceedings and remanding the case to the primary examiner, and this it is ready to verify.

5. And for a plea to so much of the said return as denies that the decisions referred to in the said petition and return relating to the said public-use proceedings established a rule of practice providing for a contested proceeding which was to be conducted in accordance with the rules in interference cases, the said relator re-avers that the aforesaid decisions did establish a rule of practice in said Patent Office providing for a contested proceeding which was to be conducted in accordance with the rules in interference cases and this the relator is ready to verify.

6. And for a further plea to so much of the said return as is specified in the plea immediately preceding this plea, the relator says that the aforesaid decisions in the said preceding plea mentioned established the said rule of practice and that thereupon there grew up and was established a custom in the said office in accordance with the said decisions which custom has been uniformly followed until the same was first departed from in this case only by one Charles H. Duell, the immediate predecessor of the said respondent in his office of Commissioner of Patents as aforesaid, as set forth in the petition of the relator for the said writ of mandamus, and this the said relator is ready to verify.

7. And for a plea to so much of the said return as avers
96 that the rules of practice do not specifically prescribe the procedure in public-use investigations, the said relator says that the said rules of practice do specifically describe the procedure in public-use investigation and this it is ready to verify.

8. And for a plea to so much of the said return, as shows to the court that the said respondent as such Commissioner of Patents has judicially determined that the investigation of the questions of public use in this case is not warranted, the said relator says that the said respondent ought not to be admitted or received to plead that he, the said respondent, as such Commissioner of Patents, has judicially determined that the investigation of the question of public use in this case is not warranted, because it saith that as soon as it was brought to the notice of the said relator that the said respondent had passed the hereinbefore-recited order, an agreement was made

between the said respondent and Richard N. Dyer and Leonard H. Dyer, who were then the attorneys of the relator, that no further action should be taken in the said public-use proceedings until the relator should have filed its petition in the supreme court of the District of Columbia for a mandamus to said respondent to compel him as Commissioner of Patents to grant to your relator the rights of a party in interest in the said public-use proceeding and to conduct the said proceedings as a contested case under the practice prevailing in the United States Patent Office and in accordance with a decision of the supreme court of the District of Columbia in what is known as the Alteneck case and further until the decision of

97 the said court upon the said petition should have been made.

Further the relator says that acting under said agreement its said attorneys did not notify the said office and the said McDonald as in the said order required as they should have done had they not relied upon the aforesaid agreement with the said respondent, and further it says that in reliance upon the said agreement, they did prepare and file in the supreme court of the District of Columbia, the said petition for mandamus which is the pending proceedings and that the said judicial determination of the said respondent to the effect that the investigation of the question of public use in this case is not warranted was in direct violation of the aforesaid agreement, and this the said relator is ready to verify. Wherefore it prays judgment if the said respondent ought to be admitted or received to his said plea contrary to his own knowledge and agreement as aforesaid.

RICHARD M. DYER,
LEONARD H. DYER,
R. ROSS PERRY AND SON,
Attorneys for Relator.

98

Withdrawal of Pleadings, &c.

Filed June 25, 1902.

In the Supreme Court of the District of Columbia.

THE UNITED STATES OF AMERICA on the Re-
lation of the National Phonograph Co.,
Relator,

vs.

FREDERICK I. ALLEN, Commissioner of Pat-
ents, Respondent.

} At Law. No. 45225.

The respondent with the leave of the court withdraws all of his pleadings filed subsequent to his answer, filed April 9, 1902, and demurs to the pleas of the relator filed April 21, 1902, as bad in substance. This is done with the express understanding that if the demurrer is overruled the pleadings may be refiled.

JOHN M. COIT,
Counsel for Respondent.

99 Supreme Court of the District of Columbia.

THURSDAY, *October 23, 1902.*

Session resumed pursuant to adjournment, Chief Justice Bingham presiding.

* * * * *

UNITED STATES OF AMERICA <i>ex Relatione</i> National Phonograph Company, Relator, <i>vs.</i> FREDERICK I. ALLEN, Commissioner of Patents, Respondent.	}	At Law. No. 45225.
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This cause coming on to be heard upon the demurrer of the respondent to the replication of the relator to the return of the respondent to the rule to show cause, and the same having been argued and considered, it is ordered that said demurrer to the replication aforesaid be, and hereby is, sustained: Therefore it is considered that the prayers of the petition for a writ of mandamus be, and are, denied; the rule to show cause is hereby discharged, and the petition
 100 of the relator be, and hereby is dismissed at the costs of said relator.

Appeal noted by the relator to the Court of Appeals, and leave granted it to deposit with the clerk of this court the sum of one hundred dollars in lieu of a bond.

Memorandum.

November 3, 1902.—\$100 deposited by appellant in lieu of appeal bond.

101 *Direction to Clerk as to Record.*

Filed November 6, 1902.

In the Supreme Court of the District of Columbia.

UNITED STATES <i>ex Rel.</i> NATIONAL PHONO- graph Co., Relator, <i>vs.</i> FREDERICK I. ALLEN, Commissioner of Patents, Respondent.	}	At Law. No. 45225.
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The clerk will please include transcripts of the following papers in the making up of record upon appeal:

1. Petition for mandamus filed Feb. 7, 1902, and exhibits thereto.
2. Return of respondent to the rule to show cause filed April 9, 1902.
3. Exceptions to return filed April 12, 1902.
4. Replication filed April 21, 1902.
5. Withdrawal of pleadings and demurrer filed to the pleas, filed June 25, 1902.
6. Final order and appeal.

R. ROSS PERRY,
Of Counsel for the Relator.

102 Supreme Court of the District of Columbia.

UNITED STATES OF AMERICA, } ss :
District of Columbia,

I, John R. Young, clerk of the supreme court of the District of Columbia, hereby certify the foregoing pages, numbered from 1 to 101, inclusive, to be a true and correct transcript of the record, as per directions of counsel herein filed, copy of which is made part of this transcript, in cause No. 45225, at law, wherein The United States of America on the relation of National Phonograph Company, is relator and Frederick I. Allen, Commissioner of Patents, is respondent, as the same remains upon the files and of record in said court.

In testimony whereof, I hereunto subscribe
Seal Supreme Court my name and affix the seal of said court, at the
of the District of city of Washington, in said District, this 12
Columbia. day of November, A. D. 1902.

JOHN R. YOUNG, *Clerk*.

Endorsed on cover: District of Columbia supreme court. No. 1257. The United States of America on the relation of National Phonograph Company, appellant, vs. Frederick I. Allen, Commissioner of Patents. Court of Appeals, District of Columbia. Filed Nov. 13, 1902. Robert Willett, clerk.